Supreme Court, U.S.
FILED
FEB 20 1987
JOSEPH F. SPANIOL, JR.
CLERK

(6) (6) (6)

Nos. 86-495, 86-624 and 86-625

IN THE

Supreme Court of the United States

OCTOBER TERM, 1986

K MART CORPORATION,
Petitioner,
v.
CARTIER, INC., *et al.*

47TH STREET PHOTO, INC.,
Petitioner,
v.
COALITION TO PRESERVE THE INTEGRITY OF AMERICAN TRADEMARKS, *et al.*

UNITED STATES OF AMERICA, *et al.*,
Petitioners,
v.
COALITION TO PRESERVE THE INTEGRITY OF AMERICAN TRADEMARKS, *et al.*

On Writs of Certiorari to the United States Court of Appeals for the District of Columbia Circuit

---

JOINT APPENDIX

[List of Counsel Appears on the Inside Cover]

PETITION FOR CERTIORARI IN NO. 86-495 FILED SEPTEMBER 26, 1986

PETITIONS FOR CERTIORARI IN NOS. 86-624 AND 86-625 FILED OCTOBER 16, 1986

CERTIORARI GRANTED AND CASES CONSOLIDATED DECEMBER 8, 1986

ROBERT W. STEELE *
ROBERT E. HEBDA
Steele, Simmons & Fornaciari
Suite 850
2020 K Street, N.W.
Washington, D.C. 20006-1857
(202) 887-1779

JAMES C. TUTTLE
Assistant General Counsel
Antitrust and International
K mart Corporation
International Headquarters
3100 West Big Beaver Road
Troy, Michigan 48084
(313) 643-1688

Attorneys for Petitioner
K mart Corporation

NATHAN LEWIN *
JAMIE S. GORELICK
Miller, Cassidy, Larroca
& Lewin
Suite 500
2555 M Street, N.W.
Washington, D.C. 20037
(202) 293-6400

Attorneys for Petitioner
47th Street Photo, Inc.

CHARLES FRIED
Solicitor General
Department of Justice
Washington, D.C. 20530
(202) 633-2217

Attorney for the
Federal Petitioners

WILLIAM H. ALLEN *
ELIZABETH V. FOOTE
Covington & Burling
1201 Pennsylvania Avenue, N.W.
P.O. Box 7566
Washington, D.C. 20044
(202) 662-6000

Attorneys for Respondents

* Counsel of Record

February 21, 1987

TABLE OF CONTENTS

	Page
Chronological List of Relevant Docket Entries in the United States District Court for the District of Columbia	1
Chronological List of Relevant Docket Entries in the United States Court of Appeals for the District of Columbia Circuit	11
Articles 475-80 of the Customs Regulations of 1923, T.D. 40,380	17
Articles 517-22 of the Customs Regulations of 1931	21
T.D. 48,537 (1936)	27
Articles 536-41 of the Customs Regulations of 1937	31
Sections 11.14-11.17 of the Customs Regulations of 1943	39
Sections 11.14-11.17 of the Customs Regulations of 1947	45
Letter from Frank Dow, Commissioner of Customs, to Senator Paul H. Douglas, dated March 23, 1951	52
T.D. 53,399 (1953)	55
T.D. 54,932 (1959)	60
Letter from B.H. Flinn, Deputy Commissioner of Customs, to Walter A. Slowinski, Esq., dated July 2, 1962	62
Letter from B.H. Flinn, Deputy Commissioner of Customs, to Selig J. Levitan, Esq., dated March 15, 1963	63
T.D. 69-12(2) (1968)	65
19 C.F.R. § 11.14 (1969)	66
Letter from Walker B. Comegys, Acting Assistant Attorney General, Antitrust Division, to Myles J. Ambrose, Commissioner of Customs, dated April 19, 1971	68

TABLE OF CONTENTS—Continued

	Page
Letter from Robert V. McIntyre, Assistant Commissioner of Customs, to H. John Campaign, Esq., dated June 28, 1971	75
Exchange of correspondence between William E. Brock, United States Trade Representative, and the Commissioner of Customs, dated October 5, 1982, and November 3, 1982	77
Letter from Sens. Abdnor, Bradley, Hatch, DeConcini, D'Amato, Moynihan, and Laxalt, dated November 7, 1983, and response of Honorable Donald T. Regan, dated December 23, 1983	82
Orders granting petitions for a writ of certiorari and consolidating cases, filed December 8, 1986	86

NOTE: The following opinions, decisions, judgments and orders have been omitted in printing this Joint Appendix because they appear on the following pages in the appendices to the Petitions for Certiorari filed by K mart Corporation on September 26, 1986, and by the Federal Petitioners on October 16, 1986:

	Page of K mart Petition in No. 86-495	Page of Federal Petition in No. 86-625
Memorandum Opinion of the United States District Court for the District of Columbia, filed December 5, 1984	38a	34a
Order of the United States District Court for the District of Columbia, filed December 5, 1984	—	49a
Opinion of the United States Court of Appeals for the District of Columbia Circuit, filed May 6, 1986	1a	1a

TABLE OF CONTENTS—Continued

	Page of K mart Petition in No. 86-495	Page of Federal Petition in No. 86-625
Judgment of the United States Court of Appeals for the District of Columbia Circuit, filed May 6, 1986	—	51a
Order on issuance of mandate, filed May 6, 1986	34a	33a
Order on petitions for rehearing, filed July 18, 1986	35a	53a
Order on suggestions for rehearing *en banc*, filed July 18, 1986	36a	54a
Order on stay of mandate, filed August 6, 1986	37a	—

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

No. 84-0390

COALITION TO PRESERVE THE INTEGRITY OF AMERICAN TRADEMARKS, *et al.*,
Plaintiffs,
v.
UNITED STATES OF AMERICA, *et al.*,
Defendants.

DOCKET ENTRIES

DATE	NR.	PROCEEDINGS
1984		
Feb 6	1	COMPLAINT; appearance. (mj)
Feb 6		SUMMONS (4) issued. (mj)
Feb 8	2	AFFIDAVIT OF SERVICE upon the U.S. Attorney on 2-7-84. (ml)
Feb 8	3	AFFIDAVIT OF SERVICE upon deft. Regan on 2-7-84. (ml)
Feb 8	4	AFFIDAVIT OF SERVICE upon deft. William Van Raab on 2-7-84. (ml)
Feb 10	5	AFFIDAVIT OF SERVICE upon the U.S. Attorney General by certified mail on 2-8-84; attachment. (ml)
Feb 23	6	AMENDED COMPLAINT by pltffs. (ml)
Mar 20	7	APPEARANCE of David M. Cohen and Velta A. Melnbrencis as counsel for defts. (ml)

DATE	NR.	PROCEEDINGS
1984		
Apr 4	8	MOTION by pltffs. for summary judgment; statement of material facts; memorandum of P&A's; table of contents; table of authorities; statements in support with Exhibits 1-6; Appendices A-U. (ml)
Apr 9	9	ANSWER by defts. to amended complaint. (ml)
Apr 9		CALENDARED C/D (N). (ml)
Apr 10	10	MOTION by K Mart Corporation to intervene as a matter of right pursuant to Rule 24(a)(2) or, alternatively, for permissive intervention pursuant to Rule 24(b); affidavit of James C. Tuttle; memorandum in support; Exhibit A; Exhibit (Answer); $5.00 fee paid and credited to U.S. Treasury, (Appearance: John F. Bruce, 1730 Pennsylvania Ave., N.W., Washington, D.C. 20006, (202) 783-0800). (ml)
Apr 10	11	MOTION by 47th Street Photo to intervene as a matter of right, or alternatively for permissive intervention; memorandum in support; Attachment A; affidavit of Irving Goldstein; Attachment 1 & 2; Exhibit (Motion; Answer); $5.00 fee paid and credited to U.S. Treasury; (Appearance: Nathan Lewin; 2555 M St., N.W., Suite 500, Washington, D.C. 20037, (202) 293-6400). (ml)
Apr 11	12	MOTION by defts. for an extension of time within which to file a response to pltffs' motion for summary judgment. (ml)
Apr 16	13	PARTIAL OPPOSITION by pltfs. to motions for extension of time to respond to motion for summary judgment. (ml)

DATE	NR.	PROCEEDINGS
1984		
Apr 17		REASSIGNMENT OF CASE from Judge Sirica to Judge Gessell. (mj)
Apr 19		REASSIGNMENT of case from Judge Gesell to Judge Johnson. (md)
May 7	14	MOTION by applicants for intervention 47th Street Photo, Inc. for a thirty-day response period to pltffs' motion for summary judgment; memorandum in support. (ml)
May 9	15	OPPOSITION by pltf. to 5-7-84 motion of 47th Street Photo. (ml)
May 10	16	MOTION by applicant for intervention K-Mart Corporation for a thirty-day period to respond to pltffs' motion for summary judgment; memorandum in support. (ml)
May 11	17	OPPOSITION by pltffs. to motion of K Mart for extension of time. (ml)
May 14	18	MOTION of Progress Trading Company, Inc., for leave to file a Brief Amicus Curiae; Memorandum; Exhibit (Brief of Amicus Curiae Progress Trading Company, Inc., in opposition to pltfs' motion for summary judgment). (nb)
May 16	19	ORDER filed 5/14/84 setting status call on 5/18/84 at 10:15 and directing counsel to comply with certain requirements. (N) JOHNSON, J. (mj)
May 16	20	OPPOSITION by defts. to pltf's motion for summary judgment and cross-motion for summary judgment; statement of material facts; collective Exhibit 1 & 2; response to pltf's statement of material facts; Exhibit A; memorandum in support; table of contents; table of authorities; Exhibit A. (ml) "Let this be filed." (fiat) JOHNSON, J. (ml)

DATE	NR.	PROCEEDINGS
1984		
May 18	21	ORDER filed 5-16-84 granting motion of defts. for extension of time; and allowing defts. until 5-14-84 to file their response to pltfs' motion for summary judgment. (N) JOHNSON, J. (ml)
May 18		STATUS CALL: Motion of K-Mart to intervene as deft., granted. Motion of 47th Street Photo to intervene as deft., granted. Motion of Progress Trading Co., to file brief as amicus curiae, not ruled on. Motion of American Free Trade Association to file brief as amicus curiae, not ruled on pltf. will be allowed time to answer. K-Mart and 47th Street Photo are to answer pltfs motion for summary judgment and answer the complaint by 6-15-84. Pltf allowed until 7-2-84 to reply to all answers to Pltfs motion. Deft allowed 2 weeks thereafter to reply to Pltfs reply. Amicus brief of American Free Trade is to be filed by 6-15-84. Hearing on motions will probably be set in August. Parties are to confer and submit 3 convenient dates for the hearing to the Court. (Rep: Gloria Williams) JOHNSON, J. (nb)
May 18	22	ORDER Granting motion of K-Mart Corporation to interevene. (N) JOHNSON, J. (nb)
May 18	23	ANSWER by intervenor K-Mart Corporation to the amended complaint. (ml)
May 18	24	MOTION by intervenor K-Mart Corporation for an extension of time to file its response to pltfs' motion for summary judgment; memorandum in support; Exhibit A. (ml)
May 23	25	ORDER filed 5-18-84 granting motion of 47th Street Photo for leave to intervene. (N). JOHNSON, J. (ml)

DATE	NR.	PROCEEDINGS
1984		
May 23	26	ANSWER by intervenor 47th Street Photo to amended complaint. (ml)
May 23	27	MOTION by intervenor 47th Street Photo for extension of time to respond to motion for summary judgment. (ml)
Jun 15	28	OPPOSITION by intervenor K Mart Corporation to pltffs' motion for summary judgment and cross-motion for summary judgment; statement of material facts; response to pltfs' statement of material facts; memorandum in support; table of contents; table of authorities; Exhibits A thru C; Attachments 1 thru 7. (ml)
Jun 15	29	MOTION by four american consumers, Andy Shafer, Herbert Silver, Harry Herslos and Charles J. Linahan, Jr. for leave to participate as amici curiae; memorandum in support; Exhibit (Memorandum in Opposition). (ml)
Jun 18	30	MOTION by intervenor 47th Street Photo, Inc. for three-day extension of time; Exhibits (Motion to Dismiss; Opposition; Motion to Strike). (ml)
Jun 21	31	ORDER filed 6-20-84 granting motion of intervenor 47th Street Photo for extension of time; and allowing 47th Street Photo until 6-18-84 in which to file its motion to dismiss, its opposition to motion for summary judgment and its motion to strike. (N) JOHNSON, J. (ml)
Jun 21	32	MOTION (filed 6-18-84) by intervenor deft. 47th Street Photo, Inc. to dismiss; memorandum in support; Exhibit A & B. (ml)

DATE	NR.	PROCEEDINGS
1984		
Jun 21	33	MEMORANDUM (filed 6-18-84) by intervenor deft. 47th Street Photo, Inc. in opposition to pltffs' motion for summary judgment; statement of genuine issues; Appendix of materials in support; table of contents. (ml)
Jun 21	34	MOTION (filed 6-18-84) by intervenor deft. 47th Street Photo, Inc. to strike portions of the pltf's sworn statements; memorandum in support. (ml)
Jun 21	35	MOTION by The American Free Trade Association for leave to file brief as amicus curiae; Exhibit (Appearance; Brief). (ml)
Jun 27	36	APPEARANCE of the firm of Steele, Simmons & Fornaciari as counsel for K-Mart Corporation in lieu of Howrey & Simon. (ml)
Jul 2	37	MOTION by pltffs. for leave to file a memorandum that exceeds 45 pages; Exhibits (Oppositions). (ml)
Jul 2	38	OPPOSITION by pltfs. to motion to strike. (ml)
Jul 6	39	ORDER filed 7-5-84 granting motion of pltfs. for leave to file a memorandum that exceeds 45 pages. (N) JOHNSON, J. (ml)
Jul 6	40	OPPOSITION by pltffs. to cross-motions for summary judgment. (ml)
Jul 6	41	OPPOSITION by pltffs. to motion to dismiss. (ml)
Jul 6	42	REPLY MEMORANDUM by pltffs. in support of motion for summary judgment and memorandum in opposition to defts' and intervenors' motions for summary judgment and to dismiss; table of contents; table of authorities; Appendix V. (ml)

DATE	NR.	PROCEEDINGS
1984		
Jul 6	43	NOTICE by pltffs. of filing corrected pages to pltffs' reply memorandum in support of their motion for summary judgment and in opposition to defts' and intervenors' motions for summary judgment and to dismiss; pages 36, 37 & 42. (ml)
Jul 11	44	CONSENT MOTION by K Mart & 47th Street Photo to respond to reply memorandum for pltffs. in support of their motion for summary judgment and memorandum in opposition to defts and intervenors' motions for summary judgment and to dismiss. (ml)
Jul 13	45	CONSENT ORDER Permitting Additional Time for K-Mart and 47th St., Photo 7 days in which to respond to the Memorandum of pltfs entitled "Reply Memorandum for pltfs in support of their motion for Summary Judgment and Memorandum in opposition to defts' and intervenors motions for Summary Judgment and to dismiss to and including July 23, 1984. (N) C.J. ROBINSON (nb)
Jul 16	46	REPLY by defts'. to "pltfs'. reply memorandum for pltfs'. in support of their motion for summary judgment and memorandum in opposition to defts'. and intervenors' motions for summary judgment and to dismiss."; table of contents; table of authorities. (dc)
July 23	47	MEMORANDUM by intervenor deft. 47th Street Photo, Inc., in reply to pltfs'. memorandum in opposition to defts'. and intervenors'. motions for summary judgment and to dismiss; appendix 1. (dc)
July 23	48	REJOINDER by intervenor deft. K Mart to pltfs'. July 2, 1984 reply memorandum; table of contents; table of authorities. (dc)

DATE	NR.	PROCEEDINGS
1984		
July 23	49	NOTICE OF FILING by Intervenor 47th Street Photo, Inc. of the declaration of Irving Goldstein which shall be filed with brief of June 18, 1984; attachment. (dc)
Sep 19		MOTION of Progress Trading for leave to file a brief amicus curiae, granted; motion by American Four Consumers for leave to participate as amici curiae, granted; motion of American Free Trade Association for leave to file a brief as amicus curiae, granted; motion of 47th Street Photo to strike, denied; motion of pltf. for summary judgment heard and taken under advisement; cross-motion of the U.S. for summary judgment heard and taken under advisement; motion of 47th Street Photo to dismiss heard and taken under advisement; cross-motion of K-Mart for summary judgment heard and taken under advisement. (Rep. G. Williams) JOHNSON, J. (ml)
Sep 21	50	ORDER filed 9-19-84 granting American Free Trading Association leave to file brief as amicus curiae. (N) JOHNSON, J. (ml)
Sep 21	51	ORDER filed 9-19-84 granting Progress Trading Co., Inc. motion for leave to file a brief amicus curiae in opposition to pltfs' motion for summary judgment. (N) JOHNSON, J. (ml)
Sep 21	52	ORDER filed 9-19-84 granting motion of Four American Consumers for leave to participate as amici curiae. (N) JOHNSON, J. (ml)
Sep 21	53	BRIEF by amicus curiae Progress Trading Company, Inc. in opposition to pltffs' motion for summary judgment; table of contents; table of authorities; Exhibits 1 thru 15. (ml)

DATE	NR.	PROCEEDINGS
1984		
Sep 21	54	MEMORANDUM by Four American Consumers as amici Curiae in opposition to pltffs' motion for summary judgment; table of contents; table of cases and authorities; Exhibits A thru D; affidavit of Andy Shafer; affidavit of Herbert Silver; affidavit of Harry Herslof; affidavit of Charles J. Linahan. (ml)
Sep 21	55	APPEARANCE of Bernard Fensterwald, III on behalf of amicus curiae American Free Trade Association. (1000 Wilson Blvd., Suite 900, Arlington, VA. 22209, (703) 276-9297). (ml)
Sep 21	56	BRIEF by American Free Trade Association as amicus curiae; table of contents; table of authorities; Addendum; Exhibit 1. (ml)
Sept 24	57	ORDER filed 9/20/84 denying motion of 47th Street Photo, Inc., to strike portions of the pltfs. sworn statements. (N) JOHNSON, J. (mj)
Dec 10	58	MEMORANDUM OPINION & ORDER filed 12/5/84 denying intervenor-deft. 47th Street Photo's motion to dismiss for lack of subject matter jurisdiction; granting intervenor-deft. 47th Street Photo's motion to dismiss for failure to state a claim under section 42 of the Lanham Act; dismissing pltffs claims under section 42 of the Lanham Act; denying pltffs motion for summary judgment; granting federal defts motion for summary judgment; granting intervenor-deft K-Mart Corp's motion for summary judgment; entering judgment for defts. on the merits of pltffs claim under section 526 of the Tariff Act. (N) (See memo. for details) JOHNSON, J. (ew)

DATE	NR.	PROCEEDINGS
1984		
Dec 11	59	NOTICE of appeal by pltffs. from judgment entered 12/5/84; $5.00 filing fee and $65.00 docketing fee paid and credited to U.S. Copy of notice mailed to Velta A. Melbrencis, Robert W. Steele, and Nathan Lewis. (ew)
Dec 12		PRELIMINARY RECORD transmitted to USCA; USCA 84-5890

UNITED STATES COURT OF APPEALS
FOR THE DISTRICT OF COLUMBIA CIRCUIT

84-5890

APPEAL FROM THE DISTRICT COURT

COALITION TO PRESERVE THE INTEGRITY OF AMERICAN TRADEMARKS, *et al.*,
Appellants

v.

UNITED STATES OF AMERICA, *et al.*

GENERAL DOCKET

DATE	FILINGS—PROCEEDINGS
(C) 12-28-84	Copy of notice of appeal and docket entries from DC (n-4)
(C) 12-28-84	Docketing fee paid in DC on 12/11/84
(C) 12-28-84	Docketing statement mailed to counsel for appellants
(J) 01-09-85	4-Appellants' docketing statement (m-9)
(J) 02-01-85	Clerk's order that a briefing schedule is set as follows: Appellants' brief and joint appendix—03-18-85; Appellees' brief(s)—04-17-85; Appellants' reply brief, if any—05-01-85. Based upon the foregoing schedule, the Clerk shall include this case in the pool of cases that are available for selection on this Court's September/October, 1985 calendar.
(R) 03-20-85	25-Appellants' brief (p-18)
(R) 03-20-85	10-Joint appendix (vols. 1-2) (p-18)

DATE	FILINGS—PROCEEDINGS
(R) 04-11-85	4-Appellees' (K-Mart) motion for leave to file out of time motion for extension of time to file brief (m-11) [6]
(R) 04-11-85	4-Appellees' (47th St. Photo, Inc.) motion for leave to file out of time motion for extension of time to file brief (m-11) [6]
(R) 04-11-85	4-Appellees' (DOJ) motion for leave to file out of time motion for extension of time to file brief (m-11) [6]
(R) 04-16-85	Consent letter signed by counsel for both appellant and appellee for American Free Trade Association to file a brief as amicus curiae (m-15)
(R) 04-16-85	15-Amicus curiae (American Free Trade Assn.) brief (m-15)
(R) 04-17-85	Consent letter from counsel signed by both appellant and appellee for Progress Trading Co., Inc. to participate as amicus curiae (p-17)
(R) 04-17-85	15-Amicus curiae brief (Progress Trading Co., Inc.) (p-17)
(E) 04-16-85	Clerk's order granting appellees' motions to extend briefing time, and the briefing schedule is revised as follows: Appellees' brief—May 17, 1985 and Appellant's reply brief, if any—May 31, 1985. This disposition will not affect the calendaring of the instant case. (Leave to file the instant motions is granted.)
(E) 04-16-85	4-Appellee's (47th Street Photo, Inc.) motion for extension of time to file brief—GRANTED. (m-11)
(E) 04-16-85	4-Appellee's (Federal) motion for extension of time to file brief—GRANTED. (m-11)

DATE	FILINGS—PROCEEDINGS
(E)04-16-85	4-Appellee's (K-Mart) motion for extension of time to file brief—GRANTED. (m-11)
(R)05-17-85	15-Appellee's (K-Mart) brief (p-17)
(R)05-17-85	15-Appellee's (47th St. Photo) brief (m-17)
(R)05-17-85	15-Appellee's (DOJ) brief (m-17)
(R)05-30-85	4-Appellants' motion for leave to file unopposed extension of time to file brief (p-30) [6]
(E)05-31-85	Clerk's order granting appellant's motion to extend briefing time, and the briefing schedule is revised as follows: Appellant's reply brief, if any—June 5, 1985. This disposition will not affect the calendaring of the instant case. (Leave to file the instant motion is hereby granted.)
(E)05-31-85	4-Appellant's motion to extend time to file reply brief—GRANTED. (m-30)
(R)06-05-85	15-Appellant's reply brief (m-5)
(R)08-27-85	4-Letter from counsel for appellee (47th St. Photo) advising of additional authorities pursuant to FRAP 28(j) (m-26) [19]
(E)12-31-85	Clerk's order, sua sponte, that the following times are allotted for oral argument: Coalition to Preserve the Integrity of American Trademarks, Appellants—30 minutes; United States, Appellee—15 minutes; 47th Street Photo Co., Appellee—7½ minutes and K-Mart Co., Appellee—7½ minutes.
(J)01-13-86	CERTIFIED ORIGINAL RECORD (4 volumes); 3 exhibits in brown expandable folder
(T)01-13-86	15-APPELLANTS' SUPPLEMENTAL BRIEF (m-13) [25]

DATE	FILINGS—PROCEEDINGS
(E)01-17-86	Per curiam order that the motion of 47th Street Photo, Inc. for leave to file supplemental brief, one day out of time, is granted. The Clerk is directed to file said supplemental brief. Mikva, Bork and Silberman, CJs.
(E)01-17-86	15-SUPPLEMENTAL BRIEF OF APPELLEE'S (47th St. Photo) (p-16)
(E)01-16-86	4-Appellee's (47th St. Photo) motion to file supplemental brief one day out of time (p-16) [#8]
(F)01-22-86	ARGUED before Mikva, Bork & Silberman, CJs BIN [52-3]
(T)01-31-86	4-Letter from counsel for appellee (47th Street Photo) advising of additional authorities pursuant to FRAP 28(j) (m-31) [8]
(D)05-06-86	Opinion for the Court filed by Circuit Judge Silberman.
(D)05-06-86	Judgment by this Court that the judgment of the District Court appealed from in this cause is hereby reversed and this case is remanded, in accordance with the Opinion for the Court filed herein this date.
(D)05-06-86	Mandate order.
(J)05-12-86	4-Appellant's bill of costs (m-12) (9)
(E)06-20-86	15-Appellees' (US) petition for rehearing and suggestion for rehearing en banc (m-20) [#1]
(E)06-20-86	15-Appellee's (47th Street Photo, Inc.) petition for rehearing and suggestion for rehearing en banc (m-20) [#1]
(E)06-20-86	15-Appellee's (K-Mart Corporation) petition for rehearing and suggestion for rehearing en banc (m-20) [#1]
(E)06-24-86	4-Appellees' (US) motion for leave to substitute petition for rehearing (p-24)

DATE	FILINGS—PROCEEDINGS
(E) 06-25-86	Clerk's order granting appellees' motion for leave to file a substituted petition for rehearing. The Clerk is directed to file the lodged substituted petition for rehearing.
(E) 06-25-86	15-Appellees' (US) substituted petition for rehearing and suggestion for rehearing en banc (p-24) [#1]
(R) 06-24-86	4-Appellees' motion for leave to substitute their petition for rehearing (m-24) [1]
(T) 06-30-86	15-Motion of Amicus Curiae American Free Trade Association for leave to file brief in support of petitions for rehearing with suggestion for rehearing en banc (m-27) [1]
(E) 07-18-86	Per curiam order, en banc, granting the motion of the American Free Trade Association for leave to file a brief amicus curiae in support of the petitions for rehearing and suggestions for rehearing en banc, and the Clerk is directed to file the lodged brief of amicus curiae. CJ Robinson, Wald, Mikva, Edwards, Ginsburg, Bork, Scalia, Starr, Silberman, Buckley and Williams, CJs.
(E) 07-18-86	15-AMICUS CURIAE BRIEF OF THE AMERICAN FREE TRADE ASSOCIATION (in support of the petitions for rehearing and suggestions for rehearing en banc) (m-30)
(E) 07-18-86	Per curiam order that the petitions for rehearing of the United States, K-Mart Corporation and 47th Street Photo, Inc., are denied. Mikva, Bork and Silberman, CJs.
(E) 07-18-86	Per curiam order, en banc, that the suggestions for rehearing en banc of the United States, K-Mart Corporation and 47th Street

DATE	FILINGS—PROCEEDINGS
	Photo, Inc. are denied. CJ Robinson, Wald, Mikva, Edwards, Ginsburg, Bork, Scalia, Starr, Silberman, Buckley and Williams, CJs. (Scalia and Williams, CJs, did not participate in this order.)
(R) 07-23-86	4-Petition of K Mart Corporation for stay of mandate (p-23) [1]
(R) 07-24-86	4-Petition of Defendants-Appellees for a stay of the issuance of the mandates (p-24) [1]
(R) 07-28-86	4-Appellant's oposition to petition of apellees for a stay of the issuance of the mandate (m-28) [1]
(R) 07-31-86	4-Reply of K Mart Corporation in support of its petition for stay of mandates [1]
(E) 08-06-86	Per curiam order granting the motions for stay of issuance of the mandate. The Clerk is directed to withhold issuance of this Court's mandate through September 30, 1986. Mikva, Bork and Silberman, CJs.
(R) 09-26-86	Certified copy of Notice from Supreme Court in SC No. 86-495 dated 9/26/86 that a petition for writ of certiorari is pending [1]
(R) 10-02-86	Notice from Clerk, SC advising that petition for certiorari was filed in SC No. 86-495 on 9-26-86 [1]
(R) 10-23-86	Notice from Clerk, Supreme Court advising that petition for writ of certiorari was filed in SC No. 86-625 on 10-16-86 [1]

[Articles 475-80 of the Customs Regulations of 1923, T.D. 40,380]

TRADE-MARKS AND TRADE NAMES.

Act Feb. 20, 1905, sec. 27; act May 4, 1906, sec. 3; act Mar. 19, 1920, sec. 6; tariff act of 1922, sec. 526(a).
T.Ds. 26198, 27416, 29975, 37021, 38035.

Art. 475. **Prohibition of entry.**—Entry is prohibited by imported merchandise which shall copy or simulate the name of any domestic manufacture or manufacturer or trader, or of any manufacturer or trader located in any foreign country which, by treaty, convention, or law affords similar privileges to citizens of the United States, or which shall copy or simulate a trade-mark registered in accordance with the provisions of the acts approved February 20, 1905, May 4, 1906, and March 19, 1920, or shall bear a name or mark calculated to induce the public to believe that the article is manufactured in the United States or that it is manufactured in any foreign country or locality other than the country or locality in which it is in fact manufactured.

T.D. 26198.

Art. 476. **Trade-marks—Registration.**—Domestic or foreign manufacturers or traders, to avail themselves of the privileges of the law concerning trade-marks, are required to register their trade-marks with the Commissioner of Patents before the Treasury Department can act.

T.D. 38035.

Applications for the recording of trade-marks with the Treasury Department must state the name of the owner, his residence, and the locality in which the goods are

manufactured, and be accompanied with one certified copy of the certificate of registration issued by the Commissioner of Patents in accordance with the act of February 20, 1905. The application will also state the names of the ports to which the facsimiles are to be sent and be accompanied by one uncertified printed Patent Office copy (commonly known as "soft copy") of the statement and two facsimiles for each port mentioned in the application and five additional copies for the use of the department.

Sec. 526, tariff act 1922.

Trade-marks owned by an American citizen or by a corporation or association created or organized within the United States are entitled to the protection of section 526 of the tariff act of 1922 if the mark has been registered in the United States Patent Office by a person (corporation or association) domiciled in the United States, or where trade-mark rights have been acquired by assignment, subsequent to original registration, by a person (corporation or association) domiciled in the United States, if the assignment has been recorded in the Patent Office, as required in section 10 of the trade-mark act of February 20, 1905, and if the mark in either case is also recorded in the Treasury Department under section 27 of the trade-mark act of 1905. If the trade-mark has been acquired by assignment there shall be transmitted to the Treasury Department with the application for recording, in addition to the documents and information specified in the preceding article of these regulations, a certified abstract of title from the records of the United States Patent Office showing the title to the mark to be in the applicant or person in whose behalf the application is made.

Art. 477. **Trade names—Registration.**—To register the trade name (not a trade-mark) of a domestic manufacturer or trader, the application must be made to the

Treasury Department, and be accompanied by proof that the applicant has the sole and exclusive right to the use of such trade name, and a statement of the country or locality in which his goods are manufactured, which proof shall be in the form of affidavits by the owner or owners and other persons having knowledge of the facts.

Such applications should state the names of the ports of entry at which the trade name is to be recorded.

Affidavits accompanying applications to record the trade names of manufacturers or traders located in foreign countries should be acknowledged before an American consular officer.

T.D. 26198.

Art. 478. **Illegal importations.**—The collector, upon receiving notice from the department of the recording of a trade name or trade-mark, together with facsimile copies thereof, will issue instructions to prevent the unauthorized entry at the customhouse of articles bearing marks or names or simulating the same.

No fees are charged for recording trade-marks or trade names in the Treasury Department.

Act of Feb. 20, 1905, sec. 27.
T.D. 26198.

Art. 479. **Name or marking inducing belief of American manufacture.**—Especial attention is invited to the prohibition against entry of articles which "shall bear a name or mark calculated to induce the public to believe that the article is manufactured in the United States, or that it is manufactured in any foreign country or locality other than the country or locality in which it is in fact manufactured," and collectors and other officers of the customs are instructed to use diligence to prevent violations of this provision.

Tariff act of 1922, 526.
T.D. 19265.

Art. 480. **Detention—Seizure—Exportation.**—Customs officers will detain, but not seize, articles imported in violation of the trade-mark act of February 20, 1905. Such articles may, upon the request of the importer, be exported under customs supervision. If no request is made for permission to export, the collector will report the facts to the department for instructions.

Should the violation not be discovered until after entry and payment of duty, the entry may be canceled and the duty refunded upon exportation of the articles. Articles imported in violation of the trade-mark provisions of section 526 of the tariff act will be subject to seizure. Importation may be allowed when written consent of the owner of the trade-mark is produced.

[Articles 517-22 of the Customs Regulations of 1931]

TRADE-MARKS AND TRADE NAMES

Art. 517. **Unlawful importation.**—(*a*) Tariff act of 1930, section 526:

(a) It shall be unlawful to import into the United States any merchandise of foreign manufacture if such merchandise, or the label, sign, print, package, wrapper, or receptacle, bears a trade-mark owned by a citizen of, or by a corporation or association created or organized within, the United States, and registered in the Patent Office by a person domiciled in the United States, under the provisions of the Act entitled "An Act to authorize the registration of trade-marks used in commerce with foreign nations or among the several States or with Indian tribes, and to protect the same," approved February 20, 1905, as amended, and if a copy of the certificate of registration of such trade-mark is filed with the Secretary of the Treasury, in the manner provided in section 27 of such Act, unless written consent of the owner of such trade-mark is produced at the time of making entry.

(b) Any such merchandise imported into the United States in violation of the provisions of this section shall be subject to seizure and forfeiture for violation of the customs laws.

(c) Any person dealing in any such merchandise may be enjoined from dealing therein within the United States or may be required to export or destroy such merchandise or to remove or obliterate such trade-mark and shall be liable for the same damages and profits provided for wrongful use of a trade-mark, under the provisions of such Act of February 20, 1905, as amended.

(*b*) United States Code, title 15, section 106:

No article of imported merchandise which shall copy or simulate the name of any domestic manufacture, or manufacturer or trader, or of any manufacturer or trader

located in any foreign country which, by treaty, convention, or law affords similar privileges to citizens of the United States, or which shall copy or simulate a trademark registered in accordance with the provisions of this subdivision of this chapter, or shall bear a name or mark calculated to induce the public to believe that the article is manufactured in the United States, or that it is manufactured in any foreign country or locality other than the country or locality in which it is in fact manufactured, shall be admitted to entry at any customhouse of the United States, and, in order to aid the officers of the customs in enforcing this prohibition, any domestic manufacturer or trader, and any foreign manufacturer or trader, who is entitled under the provisions of a treaty, convention, declaration, or agreement between the United States and any foreign country to the advantages afforded by law to citizens of the United States in respect to trademarks and commercial names, may require his name and residence, and the name of the locality in which his goods are manufactured, and a copy of the certificate of registration of his trade-mark, issued in accordance with the provisions of this subdivision of this chapter, to be recorded in books which shall be kept for this purpose in the Department of the Treasury, under such regulations as the Secretary of the Treasury shall prescribe, and may furnish to the department facsimiles of his name, the name of the locality in which his goods are manufactured, or of his registered trade-mark; and thereupon the Secretary of the Treasury shall cause one or more copies of the same to be transmitted to each collector or other proper officer of customs. (Feb. 20, 1905. c. 592, sec, 27, 33 Stat. 730.)

Act. Mar. 19, 1920 (U.S.C., title 15, sec. 126.)

(The foregoing section is applicable to marks placed on the international register provided for by section 1 of the act of March 19, 1920.) (U.S. Code, title 15, sec. 121.)

(*c*) United States Code, title 15, section 132:

Any owner of a trade-mark who shall have a manufacturing establishment within the territory of the United States shall be accorded, so far as the registration and protection of trade-marks used on the products of such establishments are concerned, the same rights and privileges that are accorded to owners of trade-marks domiciled within the territory of the United States by sections 81 to 109, inclusive, of this chapter. (May 4, 1906, c. 2081, sec. 3, 34 Stat. 169.)

T.Ds. 26198, 27416, 29975, 37021, 38035, 40380.

Art. 518. (*a*) **Prohibition of entry.**—Entry is prohibited of imported merchandise bearing a genuine trade-mark when such trade-mark is recorded with the Treasury Department and registered under the trade-mark law of February 20, 1905, if compliance is had with all provisions of section 526 of the tariff act of 1930, provided the period of protection for such trade-mark has not expired.

T.D. 41991.

(*b*) Trade-marks registered under the act of March 19, 1920, are not entitled to the protection of section 526 of the tariff act of 1930, and accordingly, goods bearing a genuine trade-mark, although registered under the act of March 19, 1920, will be permitted importation.

T.D. 26198.

Art. 519. **Trade-marks—Recording**—(*a*) Domestic or foreign manufacturers or traders, to avail themselves of the privileges of the law concerning trade-marks, are required to register their trade-marks with the Commissioner of Patents before the Treasury Department can act.

T.D. 38035.

(*b*) Applications for the recording of trade-marks with the Treasury Department should be addressed to "The Treasury Department, Bureau of Customs, Washington,

D.C.," and must state the name of the owner, his residence, and the locality in which the goods are manufactured, and be accompanied by one certified copy of the certificate of registration issued by the Commissioner of Patents in accordance with the act of February 20, 1905. The application should also be accompanied by five uncertified printed Patent Office copies (commonly known as "soft copy") of the statement and five facsimiles for the use of the bureau. No fees are charged for recording trade-marks.

(*c*) Trade-marks owned by an American citizen or by a corporation or association created or organized within the United States are entitled to the protection of section 526 of the tariff act of 1930 if the mark has been registered in the United States Patent Office by a person (corporation or association) domiciled in the United States, or where trade-mark rights have been acquired by assignment, subsequent to original registration, by a person (corporation or association) domiciled in the United States, if the assignment has been recorded in the Patent Office, as required in section 10 of the trade-mark act of February 20, 1905, and if the mark in either case is also recorded in the Treasury Department under section 27 of the trade-mark act of 1905. If the trade-mark has been acquired by assignment there shall be transmitted to the Treasury Department with the application for recording, in addition to the documents and information specified in paragraph (*b*) of this article, a certified abstract of title from the records of the United States Patent Office showing the title to the mark to be in the applicant or person in whose behalf the application is made.

T.D. 40380.

Art. 520. **Trade names—Registration.**—(*a*) To register the trade name (not a trade-mark) of a domestic manufacturer or trader, the application must be made to the Treasury Department, Bureau of Customs, Washington, D.C., and be accompanied by proof that the applicant

has the sole and exclusive right to the use of such trade name, and a statement of the country or locality in which his goods are manufactured, which proof shall be in the form of affidavits by the owner or owners and other persons having knowledge of the facts. No fees are charged for registering trade names.

(*b*) Affidavits accompanying applications to record the trade names of manufacturers or traders located in foreign countries should be acknowledged before an American consular officer.

Art. 521. **Publication of notices—Action by collectors.**—(*a*) The recording of trade-marks and the registration of trade names with the Treasury Department will be published hereafter in the weekly Treasury Decisions which will constitute notice to collectors and others concerned that such marks or names are to receive the protection accorded by law against unauthorized importations.

T.D. 26198.

(*b*) The collector, upon receiving notice from the department either by letter or by publication in the weekly Treasury Decisions of the recording of a trade-mark or the registration of a trade name, will issue instructions to prevent the unauthorized entry at the customhouse of articles bearing such marks or names or simulating the same.

T.D. 19265.

Art. 522. **Detention—Seizure—Exportation.**—(*a*) Customs officers shall detain, but not seize, articles imported in violation of the trade-mark act of February 20, 1905. Such articles may be exported under customs supervision upon the request of the importer and at his expense. If no request to export the articles is received within 30 days from the date of notice to the importer that the articles are prohibited importation, the said articles shall be seized and forfeited in the usual manner.

(*b*) Articles bearing genuine trade-marks entitled to protection under section 526 of the tariff act, if not imported by the trade-mark owner or with his written consent filed at the time of entry, shall be detained, but not seized, until 30 days have elapsed from the date of notice to the importer that the articles are prohibited importation. If the written consent of the trade-mark owner to the importation of the articles is not received within that time, the articles shall be seized and forfeited in the usual manner. Upon petition to the bureau the forfeiture may be remitted upon the condition that the articles be exported under customs supervision at the expense of the importer.

(*c*) When articles seized under the act of 1905 or under section 526 of the tariff act have been duly forfeited, the facts in the case shall be reported to the bureau for instructions as to the proper disposition of the said articles.

(*d*) Should the violation not be discovered until after entry and payment of duty, the entry may be canceled and the duty refunded and the articles disposed of in accordance with the foregoing provisions of this article.

(T.D. 48537 [1936])

Customs regulations amended—Trade-marks and trade names

Articles 518 and 522, Customs Regulations of 1931, amended to authorize, in certain cases, the release or exportation of merchandise detained for violation of trade-mark laws

TREASURY DEPARTMENT,
OFFICE OF THE COMMISSIONER OF CUSTOMS,
Washington, D.C.

To Collectors of Customs and Others Concerned:

Pursuant to the authority contained in section 251, Revised Statutes (U.S.C. title 19, sec. 66), section 27 of the Trade-Mark Act of 1905 (U.S.C. title 15, sec. 106), section 6 of the Trade-Mark Act of 1920 (U.S.C. title 15, sec. 126), and sections 526 and 624 of the Tariff Act of 1930 (U.S.C. title 19, secs. 1526 and 1624), articles 518 and 522 of the Customs Regulations of 1931 are amended to read as follows:

Art. 518. Prohibition of importation.—(*a*) Merchandise of foreign or domestic manufacture is prohibited importation when it bears a name or mark which copies or simulates a trade-mark or trade name entitled to the protection of the Trade-Mark Act of 1905 or the Trade-Mark Act of 1920, unless such merchandise is imported by or for the account of, or with the written consent of, the owner of the protected trade-mark or trade name.

(*b*) A name or mark (including a name or mark which is a genuine trade-mark or trade name in a foreign country) on an article of foreign manufacture identical with a trade-mark or trade name protected by the trade-mark laws of the United States, as well as a name

or mark on an article of foreign or domestic manufacture counterfeiting such protected trade-mark or trade name, or so resembling such protected trade-mark or trade name as to be likely to cause confusion or mistake in the minds of the public or to deceive purchasers, shall be deemed for the purposes of these regulations to copy or simulate such protected trade-mark or trade name. However, merchandise manufactured or sold in a foreign country under a trade-mark or trade name, which trade-mark is registered and recorded, or which trade name is recorded under the trade-mark laws of the United States, shall not be deemed for the purpose of these regulations to copy or simulate such United States trade-mark or trade name if such foreign trade-mark or trade name and such United States trade-mark or trade name are owned by the same person, partnership, association, or corporation.

Add "*Bourjois & Co.* v. *Aldridge* (1923), 263 U. S. 675" as a marginal reference to article 518 (*b*), as amended.

Art. 522. Detention—Seizure—Exportation—Release.—(*a*) Merchandise of foreign manufacture which bears a trade-mark entitled to the protection of section 526 of the Tariff Act of 1930, and merchandise which bears a name or mark copying or simulating a trade-mark or trade name entitled to the protection of section 27 of the Trade-Mark Act of 1905, or section 6 of the Trade-Mark Act of 1920, if not imported by or for the account of, or with the appropriate written consent of, the owner of the United States trade-mark or trade name, shall be detained, but not seized, until thirty days have elapsed from the date of notice to the importer that the merchandise is prohibited importation.

(*b*) Whenever merchandise is detained in accordance with the foregoing provisions of this article and the written consent of the owner of the trade-mark or trade name to the importation of the merchandise is not presented to

the collector prior to the expiration of the 30-day period, the merchandise shall be seized and forfeited in the usual manner, except that in any such case if the foreign value does not exceed $100 and the collector is satisfied that the importation involved neither wilful negligence nor any intention to defraud the revenue or to violate the law, he may release the merchandise, without formal seizure and without referring the matter to the Bureau, upon the condition that, within thirty days from the date of the collector's decision, the name, mark, or trade-mark be removed or obliterated prior to the release, or the merchandise be exported under customs supervision and without expense to the Government. If the value exceeds $100, the importer may petition the Commissioner of Customs, through the collector, for the release of or permission to export the merchandise under the same conditions. (See article 1120.) In any such case, however, if the name, mark, or trade-mark is indelibly impressed upon the merchandise or upon the immediate container thereof and it is impracticable to remove or obliterate the same, such merchandise may be destroyed or exported under customs supervision and at the expense of the importer, or if the immediate container alone bears the name, mark, or trade-mark the merchandise may be released after the container has been so destroyed or exported.

(*c*) Merchandise forfeited for violation of any trade-mark law may be disposed of in accordance with the procedure applicable to other customs forfeitures, but only after removal or obliteration of the name, mark, or trade-mark by reason of which the goods were seized.

(*d*) If the violation is not discovered until after entry and deposit of estimated duty, the entry shall be endorsed with an appropriate notation, the duty refunded as an erroneous collection, and the merchandise disposed of in accordance with the foregoing provisions of this article.

JAMES H. MOYLE,
Commissioner of Customs.

Approved September 22, 1936:

WAYNE C. TAYLOR,
Acting Secretary of the Treasury.

(Filed with the Division of the Federal Register
September 29, 1936, 1:04 p.m.)

[Articles 536-41 of the Customs Regulations of 1937]

TRADE-MARKS AND TRADE NAMES

Art. 536. **Unlawful importation.**—(*a*) Tariff Act of 1930, section 526:

(a) It shall be unlawful to import into the United States any merchandise of foreign manufacture if such merchandise, or the label, sign, print, package, wrapper, or receptacle, bears a trade-mark owned by a citizen of, or by a corporation or association created or organized within, the United States, and registered in the Patent Office by a person domiciled in the United States, under the provisions of the Act entitled "An Act to authorize the registration of trade-marks used in commerce with foreign nations or among the several States or with Indian tribes, and to protect the same", approved February 20, 1905, as amended, and if a copy of the certificate of registration of such trade-mark is filed with the Secretary of the Treasury, in the manner provided in section 27 of such Act, unless written consent of the owner of such trade-mark is produced at the time of making entry.

(b) Any such merchandise imported into the United States in violation of the provisions of this section shall be subject to seizure and forfeiture for violation of the customs laws.

(c) Any person dealing in any such merchandise may be enjoined from dealing therein within the United States or may be required to export or destroy such merchandise or to remove or obliterate such trade-mark and shall be liable for the same damages and profits provided for wrongful use of a trade-mark, under the provisions of such Act of February 20, 1905, as amended.

(*b*) United States Code, title 15, section 106:

No article of imported merchandise which shall copy or simulate the name of any domestic manufacture, or manufacturer or trader, or of any manufacturer or trader located in any foreign country which, by treaty, conven-

tion, or law affords similar privileges to citizens of the United States, or which shall copy or simulate a trademark registered in accordance with the provisions of this subdivision of this chapter, or shall bear a name or mark calculated to induce the public to believe that the article is manufacturer in the United States, or that it is manufactured in any foreign country or locality other than the country or locality in which it is in fact manufactured, shall be admitted to entry at any customhouse of the United States; and, in order to aid the officers of the customs in enforcing this prohibition, any domestic manufacturer or trader, and any foreign manufacturer or trader, who is entitled under the provisions of a treaty, convention, declaration, or agreement between the United States and any foreign country to the advantages afforded by law to citizens of the United States in respect to trade marks and commercial names, may require his name and residence, and the name of the locality in which his goods are manufactured, and a copy of the certificate of registration of his trade mark, issued in accordance with the provisions of this subdivision of this chapter, to be recorded in books which shall be kept for this purpose in the Department of the Treasury, under such regulations as the Secretary of the Treasury shall prescribe, and may furnish to the department facsimiles of his name, the name of the locality in which his goods are manufactured, or of his registered trade mark; and thereupon the Secretary of the Treasury shall cause one or more copies of the same to be transmitted to each collector or other proper officer of customs. (Feb. 20, 1905, c. 592, sec. 27, 33 Stat. 730.)

Act, Mar. 19, 1920 (U.S.C., title 15, sec. 126.)

(The foregoing section is applicable to marks placed on the international register provided for by section 1 of the act of Mar. 19, 1920.) (U.S. Code, title 15, sec. 121.)

(*c*) United States Code, title 15, section 132:

Any owner of a trade mark who shall have a manufacturing establishment within the territory of the United States shall be accorded, so far as the registration and protection of trade marks used on the products of such establishments are concerned, the same rights and privileges that are accorded to owners of trade marks domiciled within the territory of the United States by sections 81 to 100, inclusive, of this chapter. (May 4, 1906, c. 2081, sec. 3, 34 Stat. 169.)

(*d*) United States Code, title 48, section 1405q:

T.D. 48498.

* * * The laws of the United States relating to patents, trade marks, and copyrights, and to the enforcement of rights arising thereunder, shall have the same force and effect in the Virgin Islands as in the continental United States, and the District Court of the Virgin Islands shall have the same jurisdiction in causes arising under such laws as is exercised by United States district courts. (June 22, 1936, c. 699, sec. 18, 49 Stat.)

T.Ds. 26198, 27416, 29975, 37021, 38035, 40380, 41990, 48537.

Art. 537. **Prohibition of importation.**—(*a*) Merchandise of foreign or domestic manufacture is prohibited importation when it bears a name or mark which copies or simulates a trade mark or trade name entitled to the protection of the Trade Mark Act of 1905 or the Trade Mark Act of 1920, unless such merchandise is imported by or for the account of, or with the written consent of, the owner of the protected trade mark or trade name.

Bourjois & Co. v. Aldridge (1923), 263 U.S. 675.

(*b*) A name or mark (including a name or mark which is a genuine trade mark or trade name in a foreign country) on an article of foreign manufacture identical

with a trade mark or trade name protected by the trade-mark laws of the United States, as well as a name or mark on an article of foreign or domestic manufacture counterfeiting such protected trade mark or trade name, or so resembling such protected trade mark or trade name as to be likely to cause confusion or mistake in the minds of the public or to deceive purchasers, shall be deemed for the purposes of these regulations to copy or simulate such protected trade mark or trade name. However, merchandise manufactured or sold in a foreign country under a trade mark or trade name, which trade mark is registered and recorded, or which trade name is recorded under the trade-mark laws of the United States, shall not be deemed for the purpose of these regulations to copy or simulate such United States trade mark or trade name if such foreign trade mark or trade name and such United States trade mark or trade name are owned by the same person, partnership, association, or corporation.

T.D. 26198.

Art. 538. **Trade-marks—Recording.**—(*a*) Domestic or foreign manufacturers or traders, to avail themselves of the privileges of the law concerning trade-marks, are required to register their trade-marks with the Commissioner of Patents before the Treasury Department can act.

T.Ds. 38035, 45658, 48787.

(*b*) To record a trade-mark with the Treasury Department an application must be addressed to the Treasury Department, Bureau of Customs, Washington D.C. (which may be in the form of a letter), stating therein the name, residence, and citizenship of the owner or owners (if a partnership, the citizenship of each partner; if a corporation or association, the country or state within which it was organized or created); the name of the locality in which the goods are manufactured, and the names of the ports of entry to which the applicant desires to have facsimiles of the trade-mark transmitted. The applica-

tion must be accompanied by one certified copy of the original certificate of registration issued by the Commissioner of Patents in accordance with the Trade-Mark Act of February 20, 1905, or the Trade-Mark Act of March 19, 1920; such of the documents mentioned in paragraph (c) as are required to show the ownership of the applicant; three uncertified printed Patent Office facsimiles of the trade-mark for deposit in the Treasury Department, and a sufficient number of such facsimiles to enable the Bureau to forward copies to the port or ports of entry named in the application. The number of facsimiles necessary for each of the ports of entry is as follows:

Four facsimiles for each of the ports of New York and Chicago.

Three facsimiles for each of the ports of Baltimore and Boston.

Two facsimiles for each of the ports of Nogales, Buffalo, Tampa, Key West, Los Angeles, Portland, Me., Detroit, New Orleans, Cleveland, Cincinnati, Portland, Oreg., Philadelphia, Pittsburgh, San Antonio, San Francisco, St. Louis, St. Albans, Vt., Seattle, Milwaukee, and Saint Thomas, Virgin Islands.

One facsimile for each of the other ports of entry.

No fee is charged for recording trade-marks in the Treasury Department.

(*c*) If ownership of a registered trade-mark is claimed by an applicant by virtue of an assignment of such trade-mark, there must be transmitted with the application for recording, in addition to the documents and information specified in paragraph (*b*) of this article, a certified abstract of title from the records of the United States Patent Office showing the ownership of the applicant. Similar documentary evidence must accompany an application for recording if the commercial name of the applicant has been changed subsequent to registration of the trade-mark. If the application for recording is presented after the

expiration of the period for which the certificate of registration, or a renewal thereof, was issued, the application must be accompanied by a certified copy of a certificate of renewal from the United States Patent Office showing that the registration is in force. In order to continue to receive the protection of the trade-mark statutes with respect to imported merchandise, such a certified copy of a certificate of renewal must be filed with the Treasury Department if the period of protection expires after the trade-mark has been recorded.

T.Ds. 40380, 48787.

Art. 539. **Trade names—Recording.**—(*a*) To record the trade name (not a trade-mark) of a manufacturer or trader, an application must be addressed to the Treasury Department, Bureau of Customs, Washington, D.C. (which may be in the form of a letter), stating therein the trade name; the name, residence, and citizenship of the owner or owners (if a partnership, the citizenship of each partner; if a corporation or association, the country or state within which it was organized or created); a description of the class or kind of merchandise to which the trade name is applied, and the name of the locality in which the merchandise is manufactured. The application must be accompanied by supporting evidence, in the form of affidavits by the owner or owners and by at least two other persons having first-hand knowledge of the facts, showing that the applicant has used the trade name, in connection with the class or kind of mechandise described in the application, for a designated period of time and has the sole and exclusive right to the use of such trade name in connection with merchandise of such class or kind.

(*b*) Such affidavits accompanying an application to record the trade name of a manufacturer or trader located in a foreign country should be acknowledged before an American consular officer.

No fee is charged for recording trade names in the Treasury Department.

T.Ds. 26198, 45658, 48787.

Art. 540. **Notice to collectors—Action by collectors.**—Upon receiving notice from the Bureau of the recording of a trade-mark or a trade name the collector will issue appropriate instructions to prevent the unauthorized importation or entry at the customhouse of articles bearing marks or names which violate the statutory rights of the owner of the recorded trade-mark or trade name.

T.Ds. 19265, 47691, 48537.

Art. 541. **Detention—Seizure—Exportation—Release.**—(*a*) Merchandise of foreign manufacture which bears a trade mark entitled to the protection of section 526 of the Tariff Act of 1930, and merchandise which bears a name or mark copying or simulating a trade mark or trade name entitled to the protection of section 27 of the Trade Mark Act of 1905, or section 6 of the Trade Mark Act of 1920, if not imported by or for the account of, or with the appropriate written consent of, the owner of the United States trade mark or trade name, shall be detained, but not seized, until 30 days have elapsed from the date of notice to the importer that the merchandise is prohibited importation.

(*b*) Whenever merchandise is detained in accordance with the foregoing provisions of this article and the written consent of the owner of the trade mark or trade name to the importation of the merchandise is not presented to the collector prior to the expiration of the 30-day period, the merchandise shall be seized and forfeited in the usual manner, except that in any such case if the foreign value does not exceed $100 and the collector is satisfied that the importation involved neither wilful negligence nor any intention to defraud the revenue or to violate the law, he may release the merchandise, without formal seizure and without referring the matter to the Bureau, upon the condition that, within 30 days from the date of the collector's decision, the name, mark, or trade mark be re-

moved or obliterated prior to the release, or the merchandise be exported under customs supervision and without expense to the Government. If the value exceeds $100, the importer may petition the Commissioner of Customs, through the collector, for the release of or permission to export the merchandise under the same conditions. (See art. 1145.) In any such case, however, if the name, mark, or trade mark is indelibly impressed upon the merchandise or upon the immediate container thereof and it is impracticable to remove or obliterate the same, such merchandise may be destroyed or exported under customs supervision and at the expense of the importer, or if the immediate container alone bears the name, mark, or trade mark the merchandise may be released after the container has been so destroyed or exported.

(*c*) Merchandise forfeited for violation of any trademark law may be disposed of in accordance with the procedure applicable to other customs forfeitures, but only after removal or obliteration of the name, mark, or trade mark by reason of which the goods were seized.

(*d*) If the violation is not discovered until after entry and deposit of estimated duty, the entry shall be endorsed with an appropriate notation, the duty refunded as an erroneous collection, and the merchandise disposed of in accordance with the foregoing provisions of this article.

[Sections 11.14-11.17 of the Customs Regulations of 1943]

TRADE-MARKS AND TRADE NAMES

§ 11.14 *Trade-marks and trade names; prohibition of importation.* (a) The importation of merchandise of foreign or domestic manufacture is prohibited if such merchandise bears a name or mark which copies or simulates a trade-mark or trade name entitled to the protection of the Trade-Mark Act of February 20, 1905 (33 Stat. 724; 15 U.S.C. ch. 3), or the Trade-Mark Act of March 19, 1920 (41 Stat. 533; 15 U.S.C. ch. 3), unless such merchandise is imported by or for the account of, or with the written consent of, the owner of the protected trade-mark or trade name.

(b) A name or mark (including a name or mark which is a genuine trade-mark or trade name in a foreign country) on an article of foreign manufacture identical with a trade-mark or trade name protected by the trade-mark laws of the United States, as well as a name or mark on an article of foreign or domestic manufacture counterfeiting such protected trade-mark or trade name, or so resembling such protected trade-mark or trade name as to be likely to cause confusion or mistake in the minds of the public or to deceive purchasers, shall be deemed for the purposes of the regulations in this part to copy or simulate such protected trade-mark or trade name. However, merchandise manufactured or sold in a foreign country under a trade-mark or trade name, which trade-mark is registered and recorded, or which trade name is recorded under the trade-mark laws of the United States, shall not be deemed for the purpose of the regulations in this part to copy or simulate such United States trade-mark or trade name if such foreign trade-mark or trade name and such United States trade-mark or trade name are owned by the same person, partnership, association, or corporation. (Secs. 526, 624, 46 Stat. 741, 759; sec. 27, 33 Stat. 730; sec. 3, 34 Stat. 169; sec. 18, 49 Stat. 1811, R.S. 161; 19 U.S.C. 1624, 15 U.S.C. 106, 132, 48 U.S.C. 1405q, 5 U.S.C. 22)

§ 11.15 *Trade-marks; recording.* (a) To record a trade-mark with the Treasury Department, an application, which may be in the form of a letter, shall be addressed to the Bureau of Customs, Washington, D.C., stating the name, residence, and citizenship of the owner or owners (if a partnership, the citizenship of each partner; if a corporation or association, the country or State within which it was organized or created), the name of the locality in which the goods are manufactured, and the customs districts (designated by the names of the headquarters ports) in which the applicant desires to have facsimiles of the statement and drawing recorded. The application shall be accompanied by one certified copy of the original certificate of registration issued by the Commissioner of Patents in accordance with the Trade-Mark Act of February 20, 1905, or the Trade-Mark Act of March 19, 1920,[26] such of the documents mentioned in paragraph (b) as may be required to show the ownership of the applicant, three uncertified printed facsimiles of the statement and drawing covering the trade-mark for deposit in the Treasury Department, and a sufficient number of such facsimiles to enable the Bureau to forward copies to the headquarters ports of the customs districts indicated in the application.[27]

---

[26] Domestic or foreign manufacturers or traders, to avail themselves of the privileges of the law concerning trade-marks, are required to register their trade-marks with the Commissioner of Patents before the Treasury Department can act. (T.D. 26198)

No fee is charged for recording trade-marks in the Treasury Department. (T.D. 80006)

[27] The number of facsimiles required for each of the several customs districts and the names of the headquarters ports of those districts are as follows:

7 Baltimore, Md.
13 Boston, Mass.
8 Bridgeport, Conn.
9 Buffalo, N.Y.
3 Charleston, S.C.
4 Charlotte Amalia, St. Thomas, V. I.
6 Chicago, Ill.
11 Cleveland, Ohio
2 Denver, Colo.

(*footnote cont'd*)

(b) If ownership of a registered trademark is claimed by an applicant by virtue of an assignment of such trademark, there shall be transmitted with the application for recording, in addition to the documents and information specified in paragraph (a) of this section, a certified abstract of title from the records of the United States Patent Office showing the ownership of the applicant. Similar documentary evidence shall accompany an application for recording if the commercial name of the applicant has been changed subsequent to registration of the trade-mark. If the application for recording is presented after the expiration of the period for which the certificate of registration or a renewal thereof was issued, the application shall be accompanied by a certified copy of a certificate of renewal from the United States Patent Office showing that the registration is in force. In order to continue to receive the protection of the trade-mark statutes with respect to imported merchandise, such a certified copy of a certificate of renewal shall be filed with the Treasury Department if the period of protection expires after the trade-mark has been re-

---

10 Detroit, Mich.
16 Duluth, Minn.
5 El Paso, Tex.
7 Galveston, Tex.
18 Great Falls, Mont.
7 Honolulu, T. H.
3 Indianapolis, Ind.
2 Juneau, Alaska
17 Laredo, Tex.
9 Los Angeles, Calif.
1 Louisville, Ky.
3 Memphis, Tenn.
8 Milwaukee, Wis.
4 Minneapolis, Minn.
6 Mobile, Ala.
5 New Orleans, La.
26 New York, N.Y.
11 Nogales, Ariz.
11 Norfolk, Va.
15 Ogdensburg, N.Y.
1 Omaha, Nebr.
4 Pembina, N. Dak.
6 Philadelphia, Pa.
2 Pittsburgh, Pa.
5 Port Arthur, Tex.
21 Portland, Maine
6 Portland, Oreg.
3 Providence, R. I.
7 Rochester, N. Y.
24 St. Albans, Vt.
9 St. Louis, Mo.
5 San Diego, Calif.
7 San Francisco, Calif.
14 San Juan, P. R.
4 Savannah, Ga.
20 Seattle, Wash.
21 Tampa, Fla.
4 Wilmington, N. C.

corded. (Secs. 526, 624, 46 Stat. 741, 759, sec. 27, 33 Stat. 730, sec. 3, 34 Stat. 169, sec. 18, 49 Stat. 1811, R.S. 161; 19 U.S.C. 1526, 1624, 15 U.S.C. 106, 132, 48 U.S.C. 1405q, 5 U.S.C. 22)

§ 11.16 *Trade names; recording.* (a) To record the trade name (not a trade-mark) of a manufacturer or trader, an application, which may be in the form of a letter, shall be addressed to the Bureau of Customs, Washington, D.C., stating the trade name, the name, residence, and citizenship of the owner or owners (if a partnership, the citizenship of each partner; if a corporation or association, the country or state within which it was organized or created), a description of the class or kind of merchandise to which the trade name is applied, and the name of the locality in which the merchandise is manufactured.[28] The application shall be accompanied by supporting evidence in the form of affidavits by the owner or owners and by at least two other persons having actual knowledge of the facts, showing that the applicant has used the trade name in connection with the class or kind of merchandise described in the application for a specified period of time and has the sole and exclusive right to the use of such trade name in connection with merchandise of such class or kind.

(b) Such affidavits accompanying an application to record the trade name of a manufacturer or trader located in a foreign country shall be acknowledged before an American consular officer. (Secs. 526, 624, 46 Stat. 741, 759; sec. 27, 33 Stat. 730, sec. 3, 34 Stat. 169, sec. 18, 42 Stat. 1811, R.S. 161; 19 U.S.C. 1526, 1624, 15 U.S.C. 106, 132, 48 U.S.C. 1405q, 5 U.S.C. 22)

§ 11.17 *Detention; seizure; exportation; release.* (a) Merchandise of foreign manufacture which bears a trademark entitled to the protection of section 526, Tariff Act

---

[28] No fee is charged for recording trade names in the Treasury Department.

of 1930,[29] and merchandise which bears a mark or name copying or simulating a trade-mark or trade name entitled to the protection of section 27, Trade-Mark Act of February 20, 1905 (15 U.S.C. 106), or section 6, Trade-Mark Act of March 19, 1920 (16 U.S.C. 107, 126), if not imported by or for the account of, or with the appropriate written consent of, the owner of the United States trade-mark or trade name, shall be detained, but not seized, until 30 days have elapsed from the date of notice to the importer that the merchandise is prohibited importation.

(b) Whenever merchandise is detained in accordance with the foregoing provisions of this section and the written consent of the owner of the trade-mark or trade

---

[29] "(a) *Importation prohibited.*—It shall be unlawful to import into the United States any merchandise of foreign manufacture if such merchandise, or the label, sign, print, package, wrapper, or receptacle, bears a trademark owned by a citizen of or by a corporation or association created or organized within, the United States, and registered in the Patent Office by a person domiciled in the United States, under the provisions of the Act entitled 'An Act to authorize the registration of trade-marks used in commerce with foreign nations or among the several States or with Indian tribes, and to protect the same,' approved February 20, 1905, as amended, and if a copy of the certificate of registration of such trade-mark is filed with the Secretary of the Treasury, in the manner provided in section 27 of such Act, unless written consent of the owner of such trade-mark is produced at the time of making entry.

"(b) *Seizure and forfeiture.*—Any such merchandise imported into the United States in violation of the provisions of this section shall be subject to seizure and forfeiture for violation of the customs laws.

"(c) *Injunction and damages.*—Any person dealing in any such merchandise may be enjoined from dealing therein within the United States or may be required to export or destroy such merchandise or to remove or obliterate such trade-mark and shall be liable for the same damages, and profits provided for wrongful use of a trade-mark, under the provisions of such Act of February 20, 1905, as amended" (Tariff Act of 1930 sec. 526; 19 U.S.C. 1526).

name to the importation of the merchandise is not presented to the collector prior to the expiration of the 30-day period, the merchandise shall be seized and forfeited to the usual manner, except that in any such case within the purview of § 23.25 the collector may release the merchandise, but only upon the condition that the name, mark, or trade-mark be removed or obliterated prior to the release, or that the merchandise be exported under customs supervision and without expense to the Government. If the case is not within the purview of § 23.25, the importer may petition the Commissioner of Customs, through the collector, for the release of, or permission to export, the merchandise under the same conditions.

(c) Merchandise forfeited for violation of any trade-mark law may be disposed of in accordance with the procedure applicable to other customs forfeitures, but only after removal or obliteration of the name, mark, or trade-mark by reason of which the goods were seized.

(d) If the violation is not discovered until after entry and deposit of estimated duty, the entry shall be endorsed with an appropriate notation, the duty refunded as an erroneous collection, and the merchandise disposed of in accordance with the foregoing provisions of this section. (Secs. 526, 624, 46 Stat. 741, 759; sec. 27, 33 Stat. 730, sec. 3, 34 Stat. 169, sec. 18, 49 Stat. 1811, R.S. 161; 19 U.S.C. 1526, 1624, 15 U.S.C. 106, 1321, 48 Stat. U.S.C. 1405q, 5 U.S.C. 22)

[Sections 11.14-11.17 of the Customs Regulations of 1947]

Sections 11.14 to 11.17, inclusive, Customs Regulations of 1943 (19 CFR, Cum. Supp., 11.14-11.17), are hereby amended to read as follows:

TRADE-MARKS AND TRADE NAMES

11.14 *Trade-marks and trade names; prohibition of importation.*—(*a*) The importation of merchandise of foreign or domestic manufacture is prohibited if such merchandise bears a mark or name which copies or simulates a trade-mark or trade name recorded in the Treasury Department under the Trade-Mark Act of February 20, 1905, or the Trade-Mark Act of July 5, 1946, unless such merchandise is imported by or for the account of, or with the written consent of, the owner of the protected trade-mark or trade name.[15]

(*b*) A mark or name (including a mark or name which is a genuine trade-mark or trade name in a foreign country) on an article of foreign manufacture identical with a trade-mark or trade name recorded under the above-mentioned trade-mark laws, as well as a mark or name on an article of foreign or domestic manufacture counterfeiting such recorded trade-mark or trade name, or so

---

[15] "It shall be unlawful for any person, firm, corporation, or association, being a manufacturer of or wholesale or retail dealer in gold or silver jewelry or gold ware, silver goods or silverware, * * * to import or export or cause to be imported into or exported from the United States for the purpose of selling or disposing of the same, * * * any article of merchandise manufactured after June 13, 1907, and made in whole or in part of gold or silver, or any alloy of either of said metals, and having stamped, branded, engraved, or printed thereon, or upon any tag, card, or label attached thereto, or upon any box, package, cover, or wrapper in which said article is incased or inclosed, any mark or word indicating or designed or intended to indicate that the gold or silver or alloy of either of said metals in such article is of a greater degree of fineness than the actual fineness or quality of such gold, silver, or alloy, according to the standards and subject to the qualifications set forth in sections 295 and 296." (15 U.S.C. 294: see also 15 U.S. 295-298.)

resembling such recorded trade-mark or trade name as to be likely to cause confusion or mistake in the minds of the public or to deceive purchasers, shall be deemed to copy or simulate such protected trade-mark or trade name. However, merchandise manufactured or sold in a foreign country under a trade-mark or trade name, which trade-mark is registered and recorded, or which trade name is recorded under the above-mentioned trade-mark laws, shall not be deemed to copy or simulate such United States trade-mark or trade name if such foreign trade-mark or trade name and such United States trade-mark or trade name are owned by the same person, partnership, association, or corporation. (R. S. 161, sec. 27, 33 Stat. 730, sec. 42, Public No. 489, 79th Cong., secs. 526, 624, 46 Stat. 741, 759; 5 U. S. C. 22, 15 U. S. C. 106, 19 U. S. C. 1526, 1624.)

11.15 *Trade-marks; recording.*[16]—(*a*) To record a trade-mark with the Treasury Department, an application, which may be in the form of a letter, shall be addressed to the Bureau of Customs, Washington 25, D.C., stating the name, residence, and citizenship of the owner or owners (if a partnership, the citizenship of each partner; if a corporation or association, the country or state within which it was organized or created), and the name of the locality in which the goods are manufactured. The application shall be accompanied by one certified copy of the original certificate of registration issued by the Commissioner of Patents in accordance with the Trade-Mark Act of February 20, 1905, or section 7 of the Trade-Mark Act of July 5, 1946, to which shall be attached one printed Patent Office facsimile of the statement and drawing covering the trade-mark, such of the documents mentioned in paragraph (*b*) as may be required to show the ownership of the applicant, and 500 uncertified facsimiles

[16] "Registration on the supplemental register or under the Act of March 19, 1920, shall not be filed in the Department of the Treasury or used to stop importations." (Trade-Mark Act of July 5, 1946, sec. 28; Public No. 489, 79th Cong.)

of the statement and drawing covering the trade-mark (which may be reproduced privately from a Patent Office facsimile) for distribution to all collectors of customs and appraisers of merchandise.[17]

(*b*) If ownership of a registered trade-mark is claimed by an applicant by virtue of an assignment of such trade-mark, there shall be transmitted with the application for recording, in addition to the documents and information specified in paragraph (*a*) of this section, a certified abstract of title from the records of the United States Patent Office showing the ownership of the applicant. Similar documentary evidence shall accompany an application for recording if the commercial name of the applicant has been changed subsequent to registration of the trade-mark. If the application for recording is presented after the expiration of the period for which the certificate of registration or a renewal thereof was issued, the application shall be accompanied by a certified copy of a certificate of renewal from the United States Patent Office showing that the registration is in force. In order to continue to receive the protection of the trade-mark statutes with respect to imported merchandise, such a certified copy of a certificate of renewal shall be filed with the Treasury Department if the period of protection expires after the trade-mark has been recorded. (R. S. 161, sec. 27, 33 Stat. 730, sec. 42, Public No. 489, 79th Cong., secs. 526, 624, 46 Stat. 741, 759; 5 U. S. C. 22, 15 U. S. C. 106, 19 U. S. C. 1526, 1624.)

11.16 *Trade names; recording.*—(*a*) To record the trade name (not a trade-mark) of a manufacturer or trader an application which may be in the form of a letter, shall be addressed to the Bureau of Customs, Washington 25, D.C., stating the trade name, the name, residence, and citizenship of the owner or owners (if a partnership, the citizenship of each partner; if a corpora-

[17] No fee is charged for recording trade-marks or trade names in the Treasury Department.

tion or association, the country or state within which it was organized or created), a description of the class or kind of merchandise to which the trade name is applied, and the name of the locality in which the merchandise is manufactured. The application shall be accompanied by supporting evidence in the form of affidavits by the owner or owners and by at least two other persons having actual knowledge of the facts, showing that the applicant has used the trade name in connection with the class or kind of merchandise described in the application for a specified period of time, that the trade name is not identical with, or confusingly similar to, any other trade name or registered trade-mark used in connection with merchandise of such class or kind, and that the applicant has the sole and exclusive right to the use of such trade name in connection with merchandise of such class or kind.

(*b*) Such affidavits accompanying an application to record the trade name of a manufacturer or trader located in a foreign country shall be acknowledged before an American consular officer. (R. S. 161, sec. 27, 33 Stat. 730, sec. 42, Public No. 489; 79th Cong., secs. 526, 624; 46 Stat. 741, 759; 5 U. S. C. 22, 15 U. S. C. 106, 19 U. S. C. 1526, 1624.)

11.17 *Detention; seizure; exportation; release.*—(*a*) Merchandise of foreign manufacture which bears a trade-mark entitled to the protection of section 526, Tariff Act of 1930,[18] and merchandise which bears a mark or

[18] "(a) IMPORTATION PROHIBITED.—It shall be unlawful to import into the United States any merchandise of foreign manufacture if such merchandise, or the label, sign, print, package, wrapper, or receptacle, bears a trade-mark owned by a citizen of, or by a corporation or association created or organized within, the United States, and registered in the Patent Office by a person domiciled in the United States, under the provisions of the Act entitled 'An Act to authorize the registration of trade-marks used in commerce with foreign nations or among the several States or with Indian tribes, and to protect the same,' approved February 20, 1905, as amended, and, if a copy of the certificate of registration

name copying or simulating a trade-mark or trade name entitled to the protection of section 27, Trade-Mark Act of February 20, 1905, or section 42, Trade-Mark Act of July 5, 1946,[19] if not imported by or for the account of,

---

of such trade-mark is filed with the Secretary of the Treasury, in the manner provided in section 27 of such Act, unless written consent of the owner of such trade-mark is produced at the time of making entry.

"(b) SEIZURE AND FORFEITURE.—Any such merchandise imported into the United States in violation of the provisions of this section shall be subject to seizure and forfeiture for violation of the customs laws.

"(c) INJUNCTION AND DAMAGES.—Any person dealing in any such merchandise may be enjoined from dealing therein within the United States or may be required to export or destroy such merchandise or to remove or obliterate such trade-mark and shall be liable for the same damages and profits provided for wrongful use of a trade-mark, under the provisions of such Act of February 20, 1905, as amended." (Tariff Act of 1930, sec. 526; 19 U.S.C. 1526.)

[19] "That no article of imported merchandise which shall copy or simulate the name of any domestic manufacture, or manufacturer, or trader, or of any manufacturer or trader located in any foreign country which, by treaty, convention, or law affords similar privileges to citizens of the United States, or which shall copy or simulate a trade-mark registered in accordance with the provisions of this Act or shall bear a name or mark calculated to induce the public to believe that the article is manufactured in the United States, or that it is manufactured in any foreign country or locality other than the country or locality in which it is in fact manufactured, shall be admitted to entry at any customhouse of the United States; and, in order to aid the officers of the customs in enforcing this prohibition, any domestic manufacturer or trader, and any foreign manufacturer or trader, who is entitled under the provisions of a treaty, convention, declaration, or agreement between the United States and any foreign country to the advantages afforded by law to citizens of the United States in respect to trade-marks and commercial names, may require his name and residence, and the name of the locality in which his goods are manufactured, and a copy of the certificate of registration of his trade-mark, issued in accordance with the provisions of this Act, to be recorded in books which shall be kept for this purpose in the Department of the Treasury,

or with the appropriate written consent of, the owner of the United States trade-mark or trade name shall be detained for a period of 30 days from the date of notice to the importer that the merchandise is prohibited importation to permit the importer to secure the written consent of the owner of the trade-mark or trade name.

(*b*) Whenever merchandise is detained in accordance with the foregoing provisions of this section and the importer indicates that he will not attempt to secure the written consent of the owner of the trade-mark or trade name to the importation of the merchandise, or such consent is not presented to the collector prior to the expiration of the 30-day period, the merchandise shall be seized and forfeited in the usual manner, except that in any such case within the purview of section 23.25 the collector may release the merchandise upon the condition that the name, mark, or trade-mark be removed or obliterated prior to the release, or may permit the merchandise to be exported under customs supervision and without expense to the Government. If the case is not within the purview of section 23.25 the importer may petition the Commissioner of Customs, through the collector, for the release of, or permission to export, the merchandise under the same conditions.

(*c*) Merchandise forfeited for violation of any trade-mark law may be disposed of in accordance with the procedure applicable to other customs forfeitures, but only

---

under such regulations as the Secretary of the Treasury shall prescribe, and may furnish to the Department facsimiles of his name, the name of the locality in which his goods are manufactured, or of his registered trade-mark, and thereupon the Secretary of the Treasury shall cause one or more copies of the same to be transmitted to each collector or other proper officer of customs." (Sec. 42, Public No. 489, 79th Cong. See similar provision in Trade-Mark Act of February 20, 1905, sec. 27; 15 U.S.C. 106.)

The laws of the United States relating to patents, trade-marks, and copyrights have been extended to the Virgin Islands. (See 48 U.S.C. 1405q.)

after removal or obliteration of the name, mark, or trademark by reason of which the goods were seized.

(*d*) If the violation is not discovered until after entry and deposit of estimated duty, the entry shall be endorsed with an appropriate notation, the duty refunded as an erroneous collection, and the merchandise disposed of in accordance with the foregoing provisions of this section. (R. S. 161, sec. 27, 33 Stat. 730, sec. 42, Public No. 489, 79th Cong., secs. 526, 624, 46 Stat. 741, 759; 5 U. S. C. 22, 15 U. S. C. 106, 19 U. S. C. 1526, 1624.)

The number of this Treasury decision shall be placed opposite sections 11.13 to 11.17, inclusive, as a marginal reference.

The citation "CIE 33/43, 1/19/43" shall be placed opposite section 11.13 (*b*); the citation "BCL 1878, 8/1/38" shall be placed opposite section 11.13 (*c*); the citations "*Bourjois & Co.* v. *Aldridge*, 263 U. S. 675" and "T. D. 37021" shall be placed opposite section 11.14 (*b*), and the citation "T. D. 47691" shall be placed opposite section 11.17 (*b*) as marginal references.

(014.1)

FRANK DOW,
Acting Commissioner of Customs.

Approved October 22, 1947:

E. H. FOLEY, Jr.
Acting Secretary of the Treasury.

[Filed with the Division of the Federal Register
October 28, 1947, 8:46 a. m.]

MAR 23, 1951

My dear Senator: (Paul H. Douglas)

Further reference is made to your communication —— 1951, enclosing a letter addressed to you from Mr. ——— Worrell of Chicago, Illinois, requesting information concerning regulations governing the importation of gramophone records from England and Canada.

Mr. Worrell states that upon making inquiry at the office of the collector of customs at Chicago, he was informed that, in order to import gramophone records from England and/or Canada for his personal use, it would be necessary to obtain permission in writing from the United States office of the parent corporation controlling the foreign subsidiary from whom the records are purchased and present such authorization at the collector's office before the collector would release the projected import.

It is apparent from the contents of his letter that Mr. Worrell has had some of his records detained because of some violation of the trade-mark laws, or else he wishes to import records which will violate these laws.

Section 526 of the Tariff Act of 1930 prohibits the importation of any article of foreign manufacture if such article bears a trade-mark owned by a corporation organized within the United States, which trade-mark is duly registered in the United States Patent Office and recorded in the Treasury Department, unless a written consent of the trade-mark owner is produced at the time of making entry. Copies of this section and the customs regulations pertaining thereto are enclosed for your convenience.

It should be noted that although certain trade-marked records are prohibited importation, the prohibition is directed at the unlawful use of the trade-mark contained on the records rather than the importation of the records themselves. Therefore, if the infringing trade-marks are removed or obliterated from the records before importa-

tion, the records are not subject to the prohibition of the trade-mark laws. It is the usual practice of collectors of customs to permit tourists and innocent importers to remove or obliterate infringing marks upon ———— may secure the release of their records.

As interpreted by the Bureau, section 526 prohibits the importation of genuine articles of foreign origin bearing a genuine trade-mark valid in the foreign country, which articles were not produced by or with the authority of the United States owner of such mark. For example: if the foreign owner of a trade-mark applied to articles manufactured in a foreign country assigns the United States rights to such trade-mark to a citizen of the United States who registers and records the mark pursuant to section 526, no articles of foreign origin bearing such mark, even though genuine articles bearing the genuine trade-mark, may be imported except by or with the consent of the United States trade-mark owner. The reason for such prohibition is that the assignment of a trade-mark is ineffective without the good will of the business and the foreign trade-mark owner by the assignment has divested himself of all right to use the mark so far as the United States is concerned.

However, if the United States trade-mark owner and the owner of the foreign rights to the same mark are one and the same person, articles produced and sold abroad by the foreign owner may be imported by anyone for the reason that the trade-mark owner has himself introduced the articles into commerce or authorized such introduction and may not unreasonably restrict the use of the product thereafter. For this purpose a foreign subsidiary or licensee of the United States trade-mark owner is considered to stand in the same shoes as such trade-mark owner.

You can see from the two preceding paragraphs that the Bureau does not interpret the law as prohibiting the importation of Mr. Worrell's gramophone records assum-

ing his statements of the facts are correct. If he will furnish us with the trade-mark in question and the names of the Canadian and English firms, we shall be glad to advise him as to whether our records show that there is a parent-subsidiary relationship between the owner of record of the recorded trade-mark and said firms. On the other hand, if he can furnish positive evidence of such a relationship, we shall instruct all customs authorities not to detain importations of records manufactured by those foreign firms.

Your enclosure is returned herewith.

Very truly yours,

/s/ Frank Dow
FRANK DOW
Commissioner of Customs

Honorable Paul H. Douglas
Suite No. 189
Senate Office Building
Washington 25, D.C.

In duplicate

(T. D. 53399 [1953])

Customs Regulations amended

Customs Regulations amended to eliminate obsolete material and correct discrepancies

TREASURY DEPARTMENT,
OFFICE OF THE COMMISSIONER OF CUSTOMS,
Washington, D. C.

To Collectors of Customs and Others Concerned:

TITLE 19—CUSTOMS DUTIES

CHAPTER I—BUREAU OF CUSTOMS

To eliminate obsolete material, correct discrepancies, clarify certain provisions, and for other reasons specially indicated, the Customs Regulations are amended as follows:

• • •

PART 11—PACKING AND STAMPING; MARKING; TRADE-MARKS AND TRADE NAMES; COPYRIGHTS

Section 11.8 is amended by deleting "not" and substituting "in accordance with" for "except as provided for in" in paragraph (*h*) and by inserting "or transfer to customs territory" immediately after "withdrawal" in paragraph (*l*).

Section 11.9 (*a*) is amended by substituting "No" for "Any" at the beginning of the first sentence and by deleting "not" from that sentence.

Section 11.13 is amended by deleting footnote reference "15" at the end of paragraph (*b*) and by substituting "section 294, 1124, or 1125, title 15,[14]" for "the law set forth in footnote 14 or 15" in paragraph (*d*).

The contents of footnote 15 are added at the beginning of footnote 14 and footnote 15 is deleted.

Section 11.14 is amended by inserting the following immediately before the footnote reference "16" at the end of paragraph (*a*):

The prohibition does not apply to articles to which a copying or simulating mark has been applied, if such mark is removed or completely obliterated before importation. See section 11.17 (*b*).

by changing the period at the end of paragraph (*b*) to a comma and adding "or by a related company as defined in section 45 of the Trade-Mark Act of 1946.[17]", and by revising the citation of authority to read "R. S. 161, secs. 42, 45, 60 Stat. 440, 443, sec. 624, 46 Stat. 759; 5 U. S. C. 22, 15 U. S. C. 1124, 1127, 19 U. S. C. 1624.".

Footnote 17, appended to section 11.15 (*a*), is deleted and the following new footnote is appended to section 11.14 (*b*):

---

[17] The term "related company" means any person, partnership, association, or corporation which legitimately controls, or is controlled by, the registrant or applicant for registration in respect to the nature and quality of the goods in connection with which the mark is used. See 15 U.S.C. 1127.

Section 11.15 is amended to read as follows:

11.15 Trade-marks; recording;[16] change of ownership; renewal.—(*a*) To record a trade-mark with the Treasury Department, an application, which may be in the form of a letter, shall be addressed to the Commissioner of Customs, Washington 25, D. C., stating the name, residence, and citizenship of the owner or owners (if a partnership, the citizenship of each partner; if a corporation or association, the country or State within which it was organized or created), the name of the locality in which the goods are manufactured, and the name and address of each related company or foreign person,

partnership, association, or corporation using the trade-mark while acting as the principal or agent of the trade-mark owner. The application shall be accompanied by one certified copy of the original certificate of registration issued by the Commissioner of Patents in accordance with the Trade-Mark Act of February 20, 1905, or section 7 of the Trade-Mark Act of July 5, 1946, to which shall be attached one printed Patent Office facsimile of the statement and drawing covering the trade-mark; such of the documents mentioned in paragraph (*b*) or (*c*) as may be required to show the ownership of the applicant, or renewal of the trade-mark; 500 uncertified facsimiles of the statement and drawing covering the trade-mark (which may be reproduced privately from a Patent Office facsimile) for distribution to all collectors of customs and appraisers of merchandise; and the fee of $25 prescribed by section 24.12. Checks or money orders in payment of the fee shall be made payable to the Head, Fiscal Section, Bureau of Customs.

(*b*) If ownership of a registered trade-mark is claimed by an applicant by virtue of an assignment of such trade-mark, there shall be transmitted with the application for recording, in addition to the documents and information specified in paragraph (*a*), a certified abstract of title from the records of the United States Patent Office showing the ownership of the applicant and a statement as to whether or not the mark has been reassigned without recordation of the reassignment. Similar documentary evidence shall accompany an application for recording if the commercial name of the applicant has been changed subsequent to the registration of the trade-mark.

(*c*) If the application for recording is presented after the expiration of the period for which the certificate of registration or a renewal thereof was issued, the application shall be accompanied by a certified copy of a certificate of renewal from the United States Patent Office showing that the registration is in force. In order to

continue to receive the protection of the trade-mark statutes with respect to imported merchandise, such a certified copy of each subsequent certificate of renewal shall be promptly filed with the Treasury Department. (R. S. 161, sec. 42, 60 Stat. 440, sec. 624, 46 Stat. 759; 5 U. S. C. 22, 15 U. S. C. 1124, 19 U. S. C. 1624.)

Section 11.16 is amended by substituting "Commissioner" for "Bureau" in the first sentence of paragraph (*a*); by deleting the last "and" in that sentence; by deleting the footnote reference "17" and changing the period at the end of that sentence to a comma and adding "and the name and address of each related company or foreign person, partnership, association, or corporation using the trade name while acting as the principal or agent of the trade name owner."; by inserting "not associated with or related to the applicant but" after "two other persons" in the second sentence of paragraph (*a*); and by revising the citation of authority to read "R. S. 161, sec. 42, 60 Stat. 440, sec. 624, 46 Stat. 759; 5 U. S. C. 22, 15 U. S. C. 1124, 19 U. S. C. 1624.".

Footnote 17, appended to section 11.16 (*a*), is deleted.

Section 11.17 is amended by deleting "of foreign manufacture which bears a trade-mark entitled to the protection of section 526, Tariff Act of 1930,[18] and merchandise" from paragraph (*a*) and by revising the citation of authority to read "R. S. 161, sec. 42, 60 Stat. 440, secs. 618, 624, 46 Stat. 757, 759; 5 U. S. C. 22, 15 U. S. C. 1124, 19 U. S. C. 1618, 1624.".

Footnote 18, appended to section 11.17 (*a*), is deleted.

Section 11.18 is amended by deleting "16," from the citation of authority.

Section 11.19 is amended by deleting "(61 Stat. 652)" from paragraph (*a*), by deleting paragraph (*e*), and by revising paragraph (*d*) to read as follows:

(*d*) In the case of copyrighted works other than those specified in paragraph (*b*), application for recordation shall be made to the Commissioner of Customs, Washington 25, D. C. Such application shall be accompanied by one certified copy of the certificate of registration issued by the Copyright Office pursuant to the provisions of section 209 of the Copyright Act, 500 photographic or other adequate likenesses of the copyrighted work for distribution to all collectors of customs and appraisers of merchandise, and the fee of $25 prescribed by section 24.12. Checks or money orders in payment of the fee shall be made payable to the Head, Fiscal Section, Bureau of Customs. (Sec. 1, 61 Stat. 652; 17 U. S. C., Supp., 109.)

Section 11.21 is amended by substituting "section 1 of the Act of July 30, 1947, as amended,[24]" for "section 16, Title 17, United States Code, as amended by the Act of June 3, 1949 (Public Law No. 84, 81st Cong.),[24]" in the first sentence.

R. S. 161, 251, sec. 624, 46 Stat. 759; 5 U. S. C. 22, 19 U. S. C. 66, 1624.)

(T.D. 54932 [1959])

Trade-Marks and Trade Names—
Customs Regulations amended

Sections 11.14(*b*), 11.15(*a*) and 11.16, Customs Regulations relating to recording of trade-marks and trade names, amended

TREASURY DEPARTMENT,
OFFICE OF THE COMMISSIONER OF CUSTOMS,
Washington, D.C.

To Collectors of Customs and Others Concerned:

TITLE 19—CUSTOMS DUTIES

CHAPTER I—BUREAU OF CUSTOMS

PART 11—PACKING AND STAMPING; MARKING; TRADE-MARKS AND TRADE NAMES; COPYRIGHTS

It has been determined as a result of a study of the procedures and requirements for recording trade-marks and trade names with the Treasury Department that the requirements concerning "related companies" should be eliminated.

Accordingly, section 11.14 (*b*) is amended by deleting ", or by a related company as defined in section 45 of the Trade-Mark Act of 1946.[17]" found in the last sentence and adding a period following "corporation".

Part 11 is amended by inserting a footnote number 15 at the end of the first sentence of section 11.14(*a*). The text of the footnote shall read:

[15] "(a) It shall be unlawful to import into the United States any merchandise of foreign manufacture if such merchandise, or the label, sign, print, package, wrapper, or receptacle, bears a trade mark owned by a citizen of, or by a corporation or association created or organized within, the United States, and registered in the Patent Office by a person domiciled in the United States, under the provisions of sections 81-109 of Title 15, and if a copy of the certificate of registration of such trade mark is filed with the Secretary of the Treasury, in the manner provided in section 106 of said Title 15, unless written

consent of the owner of such trade mark is produced at the time of making entry.

"(b) Any such merchandise imported into the United States in violation of the provisions of this section shall be subject to seizure and forfeiture for violation of the customs laws.

"(c) Any person dealing in any such merchandise may be enjoined from dealing therein within the United States or may be required to export or destroy such merchandise or to remove or obliterate such trade mark and shall be liable for the same damages and profits provided for wrongful use of a trade mark, under the provisions of sections 81-109 of Title 15." (19 U.S.C. 1526.)

Part 11 is amended by deleting footnote 17.

The citation of authority for section 11.14 is amended to read "(Sec. 42, 60 Stat. 440, sec. 526, 46 Stat. 741; 15 U.S.C. 1124, 19 U.S.C. 1526.)".

Section 11.15(*a*) is amended by deleting "related company or" found in the first sentence.

Section 11.16 is amended by deleting "related company or" found in the first sentence.

(Sec. 42, 60 Stat. 440; 15 U.S.C. 1124.)

Notice of the issuance of the foregoing amendments was published in the Federal Register on May 1, 1959 (24 F.R. 3513). No arguments against the proposed amendments have been received and the amendments set forth above are hereby adopted.

These amendments shall become effective upon the expiration of 30 days after publication in the Federal Register.

(364.11)

D. B. STRUBINGER,
Acting Commissioner of Customs.

Approved September 10, 1959:

A. GILMORE FLUES,
Acting Secretary of the Treasury.

[Published in the Federal Register September 18, 1959 (24 F.R. 7522)]

Walter A. Slowinski, Esq.
Baker, McKenzie & Hightower
901 Barr Building
Washington 6, D.C.

Jul. 2, 1962

Dear Mr. Slowinski:

The Bureau has carefully considered your letter of January 15, 1962, regarding interpretation of section 11.14 (b) of the Customs Regulations when the American trademark owner has a wholly owned subsidiary abroad using the same trademark. In addition, Mr. Haderlein of your office and Mr. Long of this office discussed the matter on two or three occasions.

The Bureau agrees with your contention that an Indian corporation of which only 30 percent is owned by your client, Sprague Electric Company, North Adams, Massachusetts, is not the same corporation as Sprague Electric Company within the meaning of section 11.14(b). Accordingly, goods originating with such an Indian corporation bearing a Sprague trademark would be denied entry into the United States unless imported with the consent of the trademark owner.

The Bureau does not agree with your contention as to wholly owned foreign subsidiaries of a United States trademark owner. It is the Bureau's opinion that a foreign wholly owned subsidiary and its United States parent corporation are the same corporation within the meaning of section 11.14(b) of the Customs Regulations. This interpretation has been consistently applied for some years before insertion of the "related companies" provision in the customs regulations and since the "related companies" provision was deleted from the regulations in 1959.

Sincerely yours,

/s/ B. H. Flinn
B. H. FLINN
Deputy Commissioner
[Illegible]

Mar. 15, 1963

Felix V. Levitan, Esq.
330 Fifth Avenue
New York 20, New York

Dear Mr. Levitan:

I have your letter of February 26, 1963, in regard to the relationship between your client, Voigtlander Service Corporation and Voigtlander A. G., of Braunschweig, West Germany.

You have advised the Bureau that Voightlander Service Corporation is a wholly-owned subsidiary of Voigtlander A. G., of Braunschweig, West Germany. However, Voigtlander Service Corporation is independently operated with a separate Board of Directors, and in your opinion the foreign mark and the United States mark are not owned by the same person, partnership, association or corporation.

Section 11.14(b) of the Customs Regulations provides, in part, that "merchandise manufactured or sold in a foreign country under a trademark * * * which trademark is registered and recorded, * * * shall not be deemed to copy or simulate such United States trademark * * * if such foreign trademark and such United States trademark * * * are owned by the same person, partnership, association, or corporation."

It has been the Bureau's position for many years that in permitting anyone to import merchandise manufactured or sold by the foreign parent or subsidiary corporation of an American trademark owner is the correct interpretation of section 526 of the tariff act and section 42 of the trademark law.

Therefore, since Voigtlander, A. G., of Braunschweig, West Germany, is the parent corporation of Voigtlander Service Corporation, the Bureau will issue a circular advising customs officers at the various ports of entry of

the relationship between these concerns and that anyone may import the genuinely trademarked merchandise manufactured or sold by this foreign parent corporation.

A copy of the circular will be forwarded to you at such time as the proposed action is completed.

Sincerely yours,

/s/ B. H. Flinn
B. H. FLINN
Deputy Commissioner

(T.D. 69-12 [1968])

Abstracts of Bureau decisions

TREASURY DEPARTMENT,
OFFICE OF THE COMMISSIONER OF CUSTOMS,
Washington, D.C., December 26, 1968.

The following abstracts of Bureau of Customs decisions of general interest are published as a matter of information and guidance.

(133.121)

ROBERT V. MCINTYRE,
Assistant Commissioner,
Office of Regulations and Rulings.

TRADEMARKS

T.D. 69-12(2) *Trademarks and Trade Names.*—The trademark or trade name on imported foreign-produced merchandise shall not be deemed to copy or simulate a registered trademark or trade name, if the foreign producer is the parent or subsidiary of the American owner or the firms are under a common control. Further, if a foreign producer has been authorized by the American owner to produce and sell goods abroad bearing the recorded trademark or trade name, merchandise so produced and sold is deemed admissible. Bureau letter dated November 25, 1968. (364.11)

[19 C.F.R. § 11.14 (1969)]

TRADE-MARKS AND TRADE NAMES

§ 11.14 Trade-marks and trade names; prohibition of importation.

(a) The importation of merchandise of foreign or domestic manufacture is prohibited if such merchandise bears a mark or name which copies or simulates a trademark or trade name recorded in the Treasury Department under the Trade-Mark Act of February 20, 1905, or the Trade-Mark Act of July 5, 1946, unless such merchandise is imported by or for the account of, or with the written consent of, the owner of the protected trademark or trade name.[15] The prohibition does not apply to articles to which a copying or simulating mark has been

---

[15] "(a) It shall be unlawful to import into the United States any merchandise of foreign manufacture if such merchandise, or the label, sign, print, package, wrapper, or receptacle, bears a trade mark owned by a citizen of, or by a corporation or association created or organized within, the United States, and registered in the Patent Office by a person domiciled in the United States under the provisions of sections 81-109 of Title 15, and if a copy of the certificate of registration of such trade mark is filed with the Secretary of the Treasury, in the manner provided in section 106 of said Title 15, unless written consent of the owner of such trade mark is produced at the time of making entry.

"(b) Any such merchandise imported into the United States in violation of the provisions of this section shall be subject to seizure and forfeiture for violation of the customs laws.

"(c) Any person dealing in any such merchandise may be enjoined from dealing therein within the United States or may be required to export or destroy such merchandise or to remove or obliterate such trade mark and shall be liable for the same damages and profits provided for wrongful use of a trade mark, under the provisions of sections 81-109 of Title 15." (19 U.S.C. 1526.)

applied, if such mark is removed or completely obliterated before importation. See § 11.17(b).[16]

(b) A mark or name (including a mark or name which is a genuine trade-mark or trade name in a foreign country) on an article of foreign manufacture identical with a trade-mark or trade name recorded under the trade-mark laws mentioned in paragraph (a) of this section, as well as a mark or name on an article of foreign or domestic manufacture counterfeiting such recorded trade-mark or trade name, or so resembling such recorded trade-mark or trade name as to be likely to cause confusion or mistake in the minds of the public or to deceive purchasers, shall be deemed to copy or simulate such prorecorded under the above-mentioned trade-mark laws, as well as a mark or name on an article of foreign or domestic manufacture counterfeiting such recorded trademark or trade name, or so resembling such recorded trade-mark or trade name as to be likely to cause confusion or mistake in the minds of the public or to deceive purchasers, shall be deemed to copy or simulate such protected trade-mark or trade name. However, merchandise manufactured or sold in a foreign country under a trademark or trade name, which trade-mark is registered and recorded, or which trade name is recorded under the above-mentioned trade-mark laws, shall not be deemed to copy or simulate such United States trade-mark or trade name if such foreign trade-mark or trade name and such United States trade-mark or trade name are owned by the same person, partnership, association, or corporation. (Sec. 42, 60 Stat. 440, sec. 526, 46 Stat. 741; 15 U.S.C. 1124, 19 U.S.C. 1526)

---

[16] "Registration on the supplemental register or under the act of March 19, 1920, shall not be filed in the Department of the Treasury or be used to stop importations." (Sec. 28, 60 Stat. 436; 15 U.S.C. 1096)

ASSISTANT ATTORNEY GENERAL
ANTITRUST DIVISION

DEPARTMENT OF JUSTICE
Washington

Apr. 19, 1971

Honorable Myles J. Ambrose
Commissioner of Customs
Washington, D.C. 20226

Dear Commissioner Ambrose:

The purpose of this letter is to set forth the comments and views of the Antitrust Division of the Department of Justice on the proposed revision of certain customs regulations concerning trademarks, trade names and copyrights. 35 Fed. Reg. 19269 (December 19, 1970). It is understood that the period within which views may be submitted for consideration has been extended to April 19, 1971.

The Antitrust Division's comments and views as herein set forth are limited to those aspects of the proposed revision which are intended to carry out the provisions of Section 526 of the Tariff Act of 1930 (19 U.S.C. § 1526).

Section 526 of the Tariff Act of 1930 concerns genuine trademarks, legally applied, and states in part that it is unlawful to import

> . . . any merchandise of foreign manufacture if such merchandise . . . bears a trade-mark owned by a citizen of . . . the United States, and registered in the Patent Office . . . unless written consent of the owner of such trade-mark is produced at the time of making entry.

As is relevant here, Section 42 of the Trade-Mark Act of 1946 (15 U.S.C. § 1124) provides that no imported

merchandise which copies or simulates a registered trademark shall be admitted to entry.

Background

In January 1923, the Supreme Court held in *Bourjois Company* v. *Katzel*, 260 U.S. 689, that plaintiff's rights under certain United States registered trademarks were infringed by the defendant who imported from France and sold face powder bearing trademarks similar to plaintiff's. The marks on the imported articles were genuine and applied by a French company which had earlier sold its United States business, including good will and trademark to the plaintiff. The Court indicated that plaintiff paid a large sum of money for the business and

> . . . has spent much money in advertising, etc., so that the business has grown very great and the labels have come to be understood by the public here as meaning goods coming from the plaintiff. (p. 691)

Later in its opinion, the Court again stressed the aspect of public confusion:

> It is said that the trade mark here is that of the French house and truly indicates the origin of the goods. But that is not accurate. It is the trade mark of the plaintiff only in the United States and indicates in law, and, it is found, by public understanding, that the goods come from the plaintiff although not made by it. It was sold and could only be sold with the good will of the business that the plaintiff bought. . . . It stakes the reputation of the plaintiff upon the character of the goods. (p. 692)

The lower court in the *Katzel* case had granted an injunction in plaintiff's favor to restrain infringement. However, the Court of Appeals had reversed. Between the period when the Court of Appeals had reversed the lower court and the Supreme Court had in turn reversed

the Court of Appeals, the predecessor to Section 526 of the Tariff Act was enacted into law. In an opinion written less than two months after the Supreme Court's decision and less than six months after the predecessor to Section 526 was enacted, Judge Learned Hand stated the following:

> Section 526(a) . . . was intended only to supply the *casus omissus*, supposed to exist in Section 27 of the Act of 1905 . . . because of the decision of the Circuit Court of Appeals in *Bourjois* v. *Katzel* (275 Fed. 539). Had the Supreme Court reversed that decision last spring, it would not have been enacted at all. (*Coty* v. *Le Blume Import Co.*, 292 Fed. 264, 268-69 (SDNY 1923)).

Section 27 of the Act of 1905 was the predecessor of Section 42 of the Trade-Mark Act of 1946. In *Bourjois & Co.* v. *Aldridge*, 263 U.S. 675 (1923) (*per curiam*), responding to two certified questions from the Court of Appeals, the Supreme Court decided upon the authority of *Katzel*, that the Customs Collector was required by Section 27 to exclude from entry foreign articles genuinely marked where the sale of such articles infringed registered trademarks of plaintiff Bourjois & Co.

In summary, the *Katzel* and *Aldridge* cases hold that where an independent American company has purchased a going business, including trademarks, of distributing a foreign manufacturer's products and subsequently the public has regarded the American company, rather than the foreign company, as the source of origin of the articles, the importation and sale of the foreign-marked articles is an infringement of the American company's rights. Further Section 27 (now Section 42 of the Trade-Mark Act of 1946) requires Customs to exclude the genuine articles from entry once infringement has been judicially determined.

Discussion

Section 133.21(c) of the proposed revision* to the Customs Regulations provides in part that copying or simulating marks or names and identical trademarks shall not be denied entry in the following circumstances:

> (1) Both the foreign and U.S. trademark or trade name are owned by the same person or business entity;
>
> (2) The foreign and domestic trademark or trade name owners are parent and subsidiary companies or are otherwise subject to common ownership or control;
>
> (3) The articles of foreign manufacture bear a recorded trademark or trade name applied under authorization of the U.S. owners . . ..

The issue to which the Antitrust Division is responding herein is whether the regulation quoted above, as applicable to identical trademarks, is authorized by Section 526 of the Tariff Act of 1930. As we understand it, the basic premise behind the regulation is that Section 526 was intended by Congress to apply only to the *Katzel*-type fact pattern.

If applied literally, Section 526 arguably would allow broader protection than that allowed by the proposed regulation. However, it is our position that the legislative history of Section 526, as well as general competitive and trademark policy considerations support the narrower interpretation adopted by the proposed regulation.

If applied literally, Section 526 arguably would prohibit imports of genuine goods identical to the goods sold

---

* It appears that Section 133.21(c) of the proposed revision, as is relevant to Section 526, is essentially a restatement of past policy of the Bureau of Customs. See 19 C.F.R. 11.14 (Revised as of January 1, 1970); Treasury Decision 69-12(2) (December 26, 1968).

under U.S. trademark. Thus, for example, an American component of a multinational enterprise could insulate itself from competition from third parties who had purchased the identical article from the foreign affiliate of the American firm. Such action would not protect the consumer from deception, since they would be of identical quality. Its only effect would be to raise prices by eliminating competition.

An unlimited agreement pursuant to which an American firm had a foreign manufacturer's promise to prevent other purchasers from selling in the United States would violate antitrust laws. (See *United States* v. *Timken Roller Bearing*, 341 U.S. 593 (1951)). Since Section 526 contains no explicit language indicating that such a broad exemption to the antitrust laws is intended and since repeal of the antitrust laws implication is not favored, an interpretation of Section 526 which prevents an unnecessary elimination of competition is not only permissible but required. (See e.g. *United States* v. *Philadelphia Bank*, 374 U.S. 321, 348 (1964). Cf. Section 33(b)(7) of the Trade Mark Act of 1946).

In *United States* v. *Guerlain, Inc.*, 155 F. Supp. 77 (S.D.N.Y. 1957); *vacated and remanded*, 358 U.S. 915 (1958); *dismissed*, 172 F. Supp. 107 (S.D.N.Y. 1959); (hereinafter the "*Perfume* cases") one contention of the Government was that Section 526 did "not apply to the American part of a single international enterprise to enable it to prevent the importation into the United States of authentic products sold abroad by the foreign part of the enterprise." (155 F. Supp. at p. 80). The district court, reviewing the legislative history of the statute, agreed with the Government's position.

The Supreme Court did not have the opportunity to rule on the matter because, on appeal by the defendants, the Government moved to vacate the judgments and to remand to the district court for the latter's consideration of a Government motion to dismiss. The Government's

motion papers in the Supreme Court stated that the Bureau of Customs, under its interpretation of applicable law, had been denying entry of the foreign articles involved in the *Perfume* cases and that this intra-government conflict was better resolved through means other then antitrust litigation. The Government believed at the time that the most appropriate solution was through Congress. Motion Nos. 24, 30 and 31, October Term 1958.

The Supreme Court vacated the judgments. On remand, the district court dismissed the actions with prejudice and, in so doing, stressed the following:

> . . . it is not the position of the Solicitor General that the decisions were in error and the Government denies that it has employed a stratagem for the confession of error. (172 F. Supp. at p. 108)

It is the position of the Antitrust Division that Section 526 was directed only toward the *Katzel* decision. Had the Supreme Court disposed of the appeal in that case more quickly, Section 526 would not have been enacted. *Coty* v. *Le Blume Import Co., supra.*

There is no indication in the legislative history that Congress intended to create a broad antitrust exemption. Rather, according to Senator Sutherland, the chief supporter of the bill in the Senate debate, Congress simply wanted to protect independent American trademark owners who had made substantial investments from fraud. (62 Cong. Rec. 11603) There is clearly no danger of fraud in those situations set out in Section 133.21(c) of the proposed regulations.

Conclusion and Recommendation

The Antitrust Division believes that the adoption and implementation of the proposed revision, as discussed above, is authorized by law.

The Division recommends, for purposes of clarification that the words "or controlled" be added after the word "owned" in subsection (c)(1) of Section 133.21. Further Section 133.2 and Section 133.12 should be as ex-

plicit in requiring information concerning common ownership or control of the trademark or trade name itself as those sections are in requiring information concerning ownership or control relationships between companies using the trademark or trade name here or abroad. Therefore, we recommend that subsection (c) of Section 133.2 and subsection (c) of Section 133.12 be revised to read as follows:

> (c) The name and principal business address of each foreign person or business entity who is authorized to use the trademark [trade name] abroad by assignment, license or other agreement transferring rights, or who has authorized use of the trademark [trade name] in the United States by assignment, license or other agreement transferring rights, and a description of the terms and conditions under which such use is authorized; and

In addition, the prefatory paragraphs in Sections 133.2 and 133.12 should be revised to state that the applicant furnish all information relevant to determining whether restrictions on importation do not apply as provided in Section 133.21(c), including, but not limited to, the information required by subsection (a) through (d) of Section 133.12.

The Division also recommends that it be made clear that the information required to be filed under Section 133.2 and 133.12 must be furnished not only by new and renewal applicants, but also by those who have recorded their marks prior to the effective date of adoption of the proposed revision to the extent that such information has not previously been furnished.

Sincerely yours,

/s/ Walker B. Comegys
WALKER B. COMEGYS
Acting Assistant Attorney General
Antitrust Division

Jun. 28, 1971

H. John Campaign, Esq.
Graham, McGuire & Campaign
500 Fifth Avenue
New York, New York 10036

Dear Mr. Campaign:

Your letter of June 8, 1971, regarding the proposed amendments to the Customs Regulations adding Part 133, Trademarks, Trade Names, and Copyrights, published in the Federal Register on December 19, 1970, raises several questions.

Initially, you request confirmation of your understanding that a controlled American subsidiary and its foreign parent are the same corporation or company within the meaning of section 11.14(b) of the Customs Regulations and that the controlled American subsidiary is therefore not entitled to prevent the importation of goods made by the parent concern under section 526 of the Tariff Act. This understanding of the Bureau's position relating to section 526 and section 11.14(b) of the Customs Regulations is correct.

The comments filed pursuant to the notice of proposed rule making for Part 133 relate to many different sections of the proposed regulations, and reflect a number of differing viewpoints. An inspection of the comments would provide a clearer view of the arguments than any summary which could be prepared. The comments are available for inspection in the Division of Regulations during normal working hours, in accordance with Part 103 of the Customs Regulations. The following parties have filed comments or objections:

American Bar Association
American Patent Law Association
Association of the Bar of the City of New York
Bar Association of the District of Columbia

Bell and Howell
Chicago Bar Association
French Chamber of Commerce
Goodyear Tire and Rubber Company
Guerlain, Inc.
International Patent and Trademark Association
Mattel
New York Patent Law Association
Schenley Industries, Inc.
State Bar of Texas
United States Trademark Association

The proposed Part 133 is a part of a general revision of the Customs Regulations, which is intended to clarify the regulations and incorporate Bureau policies and procedures which ~~are not~~ in the present regulations. Specifically in regard to section 11.14(b), the proposed regulations set forth more clearly the long standing Bureau interpertation of the meaning of the last sentence relating to the effect of a relationship between foreign and domestic concerns on trademark protection.

Sincerely yours,

/s/ Robert V. McIntyre
ROBERT V. MCINTYRE
Assistant Commissioner
Office of Regulations and Rulings

THE UNITED STATES TRADE REPRESENTATIVE
Washington
20506

October 5, 1982

The Honorable William von Raab
Commissioner of Customs
U.S. Customs Service
Department of the Treasury
Washington, D.C.

Dear Mr. Commissioner:

The Entry, Licensing and Restricted Merchandise Branch of the Customs Service currently is reviewing its enforcement of section 1526 of Title 19 of the United States Code (section 1526), related to the importation, without authorization, of goods bearing trademarks registered in the U.S. I would like to bring to your attention certain laws and practices of foreign governments that limit the ability of U.S. trademark owners to control the use of their trademarks by foreign licensees. Proliferation of these laws, particularly in developing countries, may indicate that the time has come for the enforcement practices related to section 1526 to change.

Section 1526 states that importation of any merchandise of foreign manufacture bearing a trademark owned by a U.S. citizen or corporation is unlawful unless the written consent of the trademark owner is produced at the time of making entry. Goods imported in violation of this section can be seized.

The practice of the Customs Service has been to apply this provision only when asked to do so by a U.S. party with an assignment or exclusive license to rights of a foreign trademark, registered with the Office of Patents and Trademarks and recorded with the Customs Service. This practice, and the Customs Service regulations related

to enforcement (19 C.F.R. 133.21), are based upon a 1969 Treasury Department decision (T.D. 69-12(2)) that states:

> The trademark or trade names on imported foreign-produced merchandise shall not be deemed to copy or simulate a registered trademark or trade name, if the foreign producer is the parent or subsidiary of the American owner or the firms are under a common control. Further, if a foreign producer has been authorized by the American owner to produce and sell goods abroad bearing the recorded trademark or trade name, merchandise so produced and sold is deemed admissible.

It is my understanding that the rationale for taking this position was that the resources of the Customs Service ought not to be expended enforcing the provisions of private contracts. In 1969, it was possible for trademark owners, for parent companies or for subsidiaries of foreign companies to negotiate at arms length limitations and requirements related to use of a mark. A party violating the provisions of a trademark license could be sued for infringement or for violation of the contract by the other party. Arms length negotiation of trademark licenses is no longer possible in many countries.

In Yugoslavia, Brazil and Mexico, for example, a trademark owner is compelled to license the use of its trademark in order to have that trademark protected. In other countries, licensing may be necessary because high tariffs or other restrictions on imports of the merchandise that bears the trademark make importation uncompetitive. Some of the countries in which licensing is necessary also require that all trademark licenses be registered with the government in order to be enforceable in the courts of that country. Laws in these countries frequently prohibit registration of a license that contains any restriction on exports, including those to the licensor's own country.

These transfer of technology and patent and trademark laws invalidate the basic assumption underlying the 1969 Treasury decision. Trademark owners in the United States frequently cannot include restrictions on the use of their trademarks in licenses, and enforce those licenses in U.S. courts, if they are to have trademark protection in the licensee's country. Since section 1526 states that importation of trademarked merchandise is lawful only when the written consent of the U.S. trademark owner is produced at the time of making entry, could it not be enforced simply by requiring written consent of the trademark owner be produced as part of the documentation necessary for each entry of trademarked merchandise regardless of the relationship between the trademark owner and the foreign producer of the merchandise? Such a change in practice would restore some equity that has been lost as a result of changes in the laws of other countries.

I ask that you consider the changed circumstances described above as part of your review of the enforcement practices related to section 1526. I would appreciate being informed of the outcome of your deliberations.

Very truly yours,

/s/ William E. Brock
WILLIAM E. BROCK

THE COMMISSIONER OF CUSTOMS

WASHINGTON, D.C.
RES-1 CO:R:E:E:
720599 SO

NOV 3 1982

Dear Mr. Brock:

Thank you for your letter of October 5, 1982, bringing to our attention certain laws and practices of foreign governments which limit the ability of U.S. trademark owners to control the use of their trademarks by foreign licensees. You stated that these laws may indicate that the time has come for the U.S. Customs Service to change our present enforcement practices with regard to articles bearing trademarks owned by U.S. citizens or corporations imported in violation of Section 1526 of Title 19, United States Code (19 U.S.C. 1526). You suggested that importation of trademarked merchandise would be lawful only if written consent of the U.S. trademark owner is produced at the time of making entry and that the U.S. Customs Service could enforce the law simply by requiring the importer to produce the written consent of the trademark owner when entering his merchandise.

You will be pleased to hear that we are considering changing our enforcement practices as you have suggested. However, pursuant to Section 177.10(c)(2) of the Customs Regulations (19 CFR 177.10(c)(2)) and Sections 552(a)(1)(D) & (E) of the Administrative Procedure Act (5 U.S.C. 552(a)(1)(D) & (E)), publication of notice of our proposed change in position in the *Federal Register* and consideration of the comments of the public is required before the change can be implemented. Early publication of a Notice of Proposed Rulemaking is contemplated.

We appreciate receiving your views on this important matter.

Yours faithfully,

/s/ [Illegible]
Acting Commissioner of Customs

The Honorable
William E. Brock
The United States
Trade Representative
Washington, D.C. 20506

UNITED STATES SENATE
COMMITTEE ON THE JUDICIARY
Washington, D.C. 20510

November 7, 1983

The Honorable Donald T. Regan
The Secretary of the Treasury
Room 3330
15th and Pennsylvania Avenue, N.W.
Washington, D.C. 20220

Dear Mr. Secretary:

It is our understanding that you are in the process of reviewing proposed regulations drafted by the U.S. Customs Service amending 19 C.F.R. Section 133.21 to extend to all American companies regardless of foreign affiliation, so long as they are properly registered trademark owners, the same privileges with regard to the importation of trademarked goods as are now enjoyed by non-foreign-affiliated domestic corporations.

We believe that the proposed regulations reflect proper application of the trademark and trade laws. It is essential to the American consumer and worker that the integrity of trademarked goods be preserved. Trademark owners spend many millions of dollars on advertising, warranty programs, quality control programs, retail sales programs and other good business practices to deliver an excellent product and service to the consumer. When companies are not permitted to protect the integrity of their trademarks, consumers are mislead, with injury resulting both to the consumer and legitimate trademark owner.

Moreover, trademark owners, whether or not affiliated with foreign companies, directly and indirectly employ thousands of Americans. Failure to permit these companies to protect their trademarks can lead to losses of sales and a consequent reduction in the domestic work

force which is offset only to a minimal extent by the employment of diverters of trademarked goods.

In sum, we believe Customs should be allowed to proceed with its plan to protect all American trademark owners on an equal basis. We hope, Mr. Secretary, that you will personally approve the publication of these regulations.

Sincerely,

/s/ James Abdnor
JAMES ABDNOR
United States Senator

/s/ Dennis DeConcini
DENNIS DECONCINI
United States Senator

/s/ Bill Bradley
BILL BRADLEY
United States Senator

/s/ Alfonse M. D'Amato
ALFONSE M. D'AMATO
United States Senator

/s/ Orrin G. Hatch
ORRIN G. HATCH
United States Senator

/s/ Daniel P. Moynihan
DANIEL P. MOYNIHAN
United States Senator

/s/ Paul Laxalt
PAUL LAXALT
United States Senator

[SEAL]

THE SECRETARY OF THE TREASURY
Washington, D.C. 20220

December 23, 1983

Dear Dennis:

Thank you for your letter of November 7, 1983, asking us to personally approve the publication of proposed Customs Service Regulations which would extend the import protection for trademarked articles provided by Section 526 of the Tariff Act of 1930, as amended (19 U.S.C. 1526), to all American companies regardless of foreign affiliation. You believe that it is essential to the American consumer and worker that the integrity of trademarked goods be preserved and also that the proposed regulations which we are in the process of reviewing reflect proper application of the trademark and trade laws.

The Customs Service Regulations in question (19 CFR 133.21(c)(1) & (2)) are based on a judicial decision in the consolidated "perfume" cases, *United States v. Guerlain*, 155 F. Supp. 77 (S.D.N.Y. 1957), *vacated and remanded*, 358 U.S. 915 (1958), *action dismissed*, 172 F. Supp. 107 (S.D.N.Y. 1959). The 1957 decision held that the American part of a single international enterprise could not invoke the provisions of Section 526 to prevent the importation into the United States of authentic products sold abroad by the foreign part of the enterprise. The current regulations permit the unrestricted importation of trademarked products manufactured abroad where both the foreign and American trademark rights are owned by the same company or companies under common ownership or control.

However, in response to numerous petitions, we have been considering whether to issue a notice of proposed rulemaking which would change our regulations. In brief,

the change would affect Customs protection for genuine trademarks by providing that a U.S. subsidiary of a foreign corporation which was the registered owner of a trademark in the U.S. could record the mark with Customs, and Customs would prohibit the importation of genuine goods without the consent of the trademark owner.

We are aware that this is an important and controversial matter, and it is receiving interagency consideration. No final decision regarding the possible publication of a *Federal Register* notice has been reached. An issue such as this, having so great an impact on commerce, demands careful consideration. You may be assured that your views are receiving full consideration.

With best wishes.

Sincerely,

/s/ Don
DONALD T. REGAN

The Honorable
Dennis DeConcini
United States Senate
Washington, D.C. 20510

SUPREME COURT OF THE UNITED STATES

No. 86-495

K MART CORPORATION,

Petitioner

v.

CARTIER, INC., *et al.*

ORDER ALLOWING CERTIORARI

Filed December 8, 1986

The petition herein for a writ of certiorari to the United States Court of Appeals for the District of Columbia is granted. This case is consolidated with 86-624, *47th Street Photo, Inc.* v. *Coalition to Preserve the Integrity of American Trademarks, et al.* and 86-625, *United States, et al.* v. *Coalition to Preserve the Integrity of American Trademarks, et al.*, and a total of one hour is allotted for oral argument.

SUPREME COURT OF THE UNITED STATES

No. 86-624

47TH STREET PHOTO, INC.,
Petitioner

v.

COALITION TO PRESERVE THE INTEGRITY OF AMERICAN TRADEMARKS, *et al.*

ORDER ALLOWING CERTIORARI

Filed December 8, 1986

The petition herein for a writ of certiorari to the United States Court of Appeals for the District of Columbia, is granted. This case is consolidated with 86-495, *K Mart Corporation* v. *Cartier, Inc., et al.*, and 86-625, *United States, et al.* v. *Coalition to Preserve the Integrity of American Trademarks, et al.*, and a total of one hour is allotted for oral argument.

SUPREME COURT OF THE UNITED STATES

No. 86-625

UNITED STATES, *et al.*,
Petitioners

v.

COALITION TO PRESERVE THE INTEGRITY OF AMERICAN TRADEMARKS, *et al.*

ORDER ALLOWING CERTIORARI

Filed December 8, 1986

The petition herein for a writ of certiorari to the United States Court of Appeals for the District of Columbia is granted. This case is consolidated with 86-495, *K Mart Corporation* v. *Cartier, Inc., et al.*, and 86-624 *47th Street Photo, Inc.* v. *Coalition to Preserve the Integrity of American Trademarks, et al.*, and a total of one hour is allotted for oral argument.